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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1920.

No. [redacted]51

HERBERT L. HILDRETH,
Petitioner,

v.

JIM M. MASTORAS.

BRIEF FOR PETITIONER, HERBERT L. HILDRETH.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1920.

No. 333.

HERBERT L. HILDRETH, PETITIONER,

v.

JIM M. MASTORAS.

BRIEF FOR PETITIONER, HERBERT L. HILDRETH.

STATEMENT OF THE CASE.

This is a patent case relating to machines for pulling candy. It comes before this Court on a writ of certiorari granted on the petition of Herbert L. Hildreth of Boston, the plaintiff below, and directed to the Circuit Court of Appeals for the Ninth Circuit. The case originated in the District Court of the United States for the District of Oregon and relates to the infringement of claim 1 of letters patent of the United States No. 831,501 for a candy-pulling machine granted September 18, 1906, on the application of Herbert M. Dickinson. (Rec. p. 222.)

The respondent Jim M. Mastoras was formerly a licensee of the plaintiff's and surreptitiously built the alleged infringing machine, the construction of which is shown in the patent to Langer No. 1,232,697. (Rec. p. 298.)

The bill of complaint (Rec. p. 3) was filed June 2,

1917. After one deposition had been taken by the plaintiff, the petitioner herein, the case was tried in open court before Judge Wolverton who entered an interlocutory decree (Rec. p. 30) holding claim 1 of the patent in suit valid and infringed and ordering an injunction and an accounting of profits and damages. Judge Wolverton filed an elaborate opinion (Rec. p. 18) setting forth the reasons for his conclusions. On appeal to the Circuit Court of Appeals for the Ninth Circuit, the Court of Appeals reversed the District Court in an opinion (Rec. p. 333) holding that in view of a prior art patent and the "doubtful" operativeness of the machine shown in the patent in suit claim 1 is narrow in scope and was not infringed by defendant's machine. Thereupon, after his request for a rehearing had been denied, the petitioner, Hildreth, filed in this Court a petition for a writ of certiorari directed to the Ninth Circuit, and the Circuit Court of Appeals made an order staying the issuance of its mandate pending the decision of this Court on the petition for the writ of certiorari. The petition for the writ of certiorari was granted and the writ was issued October 15, 1920. (Rec. p. 346.)

OUTLINE OF ARGUMENT.

Before the invention of the patent in suit, all candy pulling was done by hand, an arduous and expensive task, producing an unhealthy, unappetizing product. After Dickinson's invention machines were substituted for men with great reduction in expense and improvement in the product; practically all pulled candy is now made on candy pulling machines.

The essential features of a candy pulling machine are three pins (two pins are not enough) and mechanism to

move the pins in such a way that each pin in turn passes between the other two engaging a strand of candy and then is one of a pair of pins which in its turn holds the candy while another pin passes between. Dickinson invented this combination.

The Court of Appeals for the Ninth Circuit said in substance that the Dickinson patent, having been preceded by the Firchau patent, is narrow in scope and consequently is not infringed by the machine built in accordance with the defendant's subsequently-granted Langer patent. The Firchau patent shows a machine which cannot pull candy because it does not have the essentials of a candy pulling machine. It has only two pins and they travel in concentric circles and therefore do not alternately seize and pull the candy, but on the contrary one pin eventually winds up all the candy on the other pin. The Firchau patent is a mere paper patent resurrected from oblivion merely for the purposes of this suit. No machines like it, except models for exhibition in court, were ever built. The contention that the Dickinson invention was anticipated by the Firchau patent was fully considered and summarily disposed of by the Patent Office; by the Court of Appeals for the District of Columbia; by Judge Rose of Baltimore, and by the Court of Appeals for the Fourth Circuit.

The Court of Appeals for the Ninth Circuit, reversing Judge Wolverton, who saw and heard the witnesses, and saw a demonstration in court, held that the machine of the patent in suit was lacking in utility because inoperative for commercial purposes and for this reason, as well as for the other reasons stated, construed the Dickinson patent narrowly. The Court of Appeals for the Ninth Circuit adopted a wrong test of operativeness. It

should have held that the machine of the patent was operative if it would work at all.

Having held that claim 1 of the Dickinson patent was limited by the prior Firchau patent, and that it ought to be narrowly construed because the machine of the patent was not a commercial success, the Court then held that the defendant's machine built under the Langer patent was not an infringement of claim 1 of the Dickinson patent. In reaching this conclusion the court relied on the grant of the defendant's Langer patent as raising a presumption that the machine shown in it did not infringe the prior Dickinson patent. No such presumption exists and the Court was wrong in assuming that there is such a presumption.

Defendant's machine is clearly an infringement of claim 1 of the Dickinson patent. Defendant's machine has three pins, and they have the peculiar relative in and out movement invented by Dickinson. In these two respects, which are the sole essentials of a candy pulling machine, defendant's machine is like Dickinson's and is unlike Firchau's. Defendant's machine differs from the Dickinson machine only in having two stationary pins and one moving pin, while the Dickinson machine has two moving pins and one stationary pin, and in having a circular path of movement instead of an irregular rectilineal path as in the Dickinson machine. These are mere superficial differences not affecting the actual operation of the machine. Furthermore, as will be seen from the diagrams printed opposite page 60 of this brief, both the Dickinson machine and the defendant's machine during each cycle of operation cause the candy to pass through five successive identical positions, thereby converting the single strand of candy into a seven fold strand.

The machines are identical in the essentials of their construction and mode of operation, and the Court of Appeals was clearly in error in holding that defendant's machine did not infringe claim 1 of the patent in suit.

For fifteen years the patent in suit has been in continuous litigation and until the decision of the Ninth Circuit in the case at bar, had always been sustained as a broad patent. The litigation began in the Patent Office in an interference in which six different types of machines, exclusive of Dickinson's were held to be covered by claim 1 of the Dickinson patent. The Firchau patent was fully considered. The four tribunals of the Patent Office and the Court of Appeals of the District of Columbia held, without dissent, that Dickinson was the pioneer inventor of the candy pulling machine. Since its grant, the Dickinson patent has been sustained in the broadest possible way—by Judge Rose of Baltimore; by the Circuit Court of Appeals for the Fourth circuit; by Judge Call of the Southern District of Florida, and by Judge Tuttle of the Eastern District of Michigan. In these cases other widely different types of machines were held to be within the scope of the patent. Notwithstanding these concurring decisions supported by compelling reasoning, the Court of Appeals for the Ninth Circuit reached an opposite conclusion and held the Langer machine not to infringe, although in construction and mode of operation it is more closely similar to the machine of the Dickinson patent than were some of the machines which were held to be within the scope of the patent in the prior litigation.

The Ninth Circuit reached its conclusion by overruling the District Court on questions of fact, as to which there was conflicting evidence; by failure to comprehend the mechanical questions involved; by adopting an

erroneous test as to what constitutes operativeness of a patent in suit, and by relying upon a non-existent presumption alleged to arise from the grant of the defendant's patent.

QUESTIONS IN THE CASE.

I. To what extent if any is claim 1 of the Dickinson patent narrowed by the existence in the prior art of the Firchau patent, and

As a corollary to this question, whether or not the Dickinson patent is a pioneer or basic patent, and therefore entitled to a broad scope?

II. Whether the machine shown in the Dickinson patent is inoperative for the purpose for which it was intended and therefore the patent is invalid, or of narrow scope, because the alleged invention is lacking in utility?

III. Whether the defendant's machine embodies the combination of elements and has a mode of operation claimed by claim 1 of the Dickinson patent and not found in the machine shown in the Firchau patent No. 511,011?

IV. What is the true test of operativeness of the machine of a patent in suit, and whether the test adopted by the Circuit Court of Appeals for the Ninth Circuit that a machine must work commercially is the correct test?

V. Whether the grant of a patent raises a presumption that it does not infringe a prior patent? On this question there is a sharp conflict of opinion between the Ninth, Eighth, and Second Circuits on one hand and the Sixth Circuit and the leading text books on the other hand.

HISTORY OF THE PATENT IN SUIT AND THE PRIOR LITIGATION.

The patent in suit is believed to be the basic patent on candy pulling machines and has been the subject of much litigation.

Dickinson made application for the patent in suit in November, 1901. About this time, several other persons filed applications in the Patent Office, and each claimed to be the pioneer inventor of the candy pulling machine. In addition to Dickinson, these persons were Hildreth (the petitioner herein), Jenner, Thibodeau, Robinson & Deiter, Henry and Igou. The Patent Office thereupon declared an interference to determine the question of priority of invention between the several inventors. This litigation in the Patent Office lasted about five years and was bitterly contested. In the course of it, the patent to Firchau No. 511,011 (Rec. p. 269), on which the Court of Appeals relied chiefly in its decision, was cited and fully discussed; and the question of the operativeness of the Dickinson machine was raised and decided favorably to Dickinson. Judgment of priority of invention was awarded to Dickinson by the Examiner of interferences, and, on successive appeals, this decision was affirmed three times, to wit, by the Board of Examiners-in-Chief, by the Commissioner of Patents and by the Court of Appeals of the District of Columbia. Hildreth, the petitioner herein, was Dickinson's chief opponent in the interference. Finding himself completely beaten on his claim to be the first inventor of the candy pulling machine and believing that the Dickinson patent would be sustained by the courts as it had been by the Patent Office and the Court of Appeals for the District

of Columbia, Hildreth bought the Dickinson application for $76,500, and the patent was issued to him as assignee.

This may be said to end the first phase of the litigation. The second phase was the litigation to enjoin infringement of the Dickinson patent.

1. *Hildreth* v. *Norton; Hildreth* v. *Curtis & Sons Co.* In these two cases suit was brought on the Dickinson patent against users of Igou machines, shown in the Igou patent (Rec. p. 272), and there were decisions on interlocutory matters, which decisions are reported, but the suits were finally settled out of court. There were no final adjudications except by consent and therefore the cases are of no importance.

2. *Hildreth* v. *Lauer & Suter Company.* (208 Fed. Rep. 1005; 219 Fed. Rep. 753). This suit charged infringement of claim 1 of the Dickinson patent by the use of Racine machines made in accordance with the Henry patent (Rec. p. 227), the application for which had been in interference with Dickinson's application. The case was tried before Judge Rose in Baltimore. He held the Dickinson patent to be a pioneer patent, and to be valid and infringed. (Rec. p. 167.) This decision was affirmed by the Circuit Court of Appeals for the Fourth Circuit. (Rec. p. 184.) More extended reference to these decisions will be found on a later page of this brief.

3. *Hildreth* v. *E. J. Smith & Company.* In this case, which was in the District Court for Florida, Judge Call held claim 1 of the Dickinson patent valid and infringed by the use of an Igou machine. This case was not appealed. The opinion was not reported but is found on page 188 of the record herein.

4. *Hildreth* v. *Koerber.* Since the trial of the case at bar, Judge Tuttle, of the District Court of Michigan, has

also sustained the Dickinson patent, holding it infringed by a machine built by the defendant Koerber. The case was appealed, but the appeal was dismissed on motion of the defendant.

The petitioner, Hildreth, has been involved in other litigation in regard to candy-pulling machines, but the above are the only suits which have any bearing on the case at bar.

Up to the time when the Circuit Court of Appeals of the Ninth Circuit handed down its opinion (Rec. p. 333) the Dickinson patent had always and without dissent been held to be valid, to disclose an operative machine, to be the pioneer patent and its claims to be entitled to a broad construction.

These conclusions were reached by—

the Primary Examiner of the Patent Office;
the Examiner of Interferences;
the three members of the Board of Examiners-in-Chief;
the Commissioner of Patents in person;
the three judges of the Court of Appeals of the District of Columbia;
his Honor Judge Rose of the District of Maryland;
the three Judges of the Circuit Court of Appeals for the Fourth Circuit;
his Honor Judge Call of Florida;
his Honor Judge Tuttle of Michigan; and
his Honor Judge Wolverton, the trial judge in the case at bar.

In view of the ten decisions concurred in by sixteen judges or judicial officers without a single dissent in which the Dickinson patent has been favorably passed upon, it is believed that the conclusions of the Court of

Appeals for the Ninth Circuit ought not to be followed unless they are correct beyond question.

DEFENDANT A LICENSEE UNDER THE DICKINSON PATENT.

At the outset, attention is called to the fact that the defendant was formerly a licensee of the plaintiff and that on October 9, 1916, which was the date when defendant's patent was applied for, he had in his possession under license from the plaintiff a machine built under the Dickinson patent. (See Plaintiff's Exhibits 10 and 11, Rec. pp. 309-322, and Kemp's deposition, Rec. p. 94.) Defendant has followed the course of many other defendants. He leased one of the plaintiff's machines and used it, thereby testifying to the utility of the invention which it embodied. Then finding the annual license fee irksome and perceiving that a similar machine could be cheaply constructed, he proceeded to build and use the alleged infringing machine without license from the plaintiff.

CANDY PULLING.

In the manufacture of many kinds of candy, of which molasses candy and stick candy are examples, the candy is subjected to a process called "pulling" after the materials have boiled to a proper consistency and the candy has been cooled enough to permit it to be handled. The pulling operation consists in repeatedly pulling or elongating the candy, doubling or folding it upon itself, and again pulling it until the candy is changed from a dense amorphous mass into a bundle of minute fibres enclosing equally minute air cells and rendering the candy lighter in color, and porous or cellular in texture. Pulling renders the candy readily soluble and brings out the

flavor; it also increases the bulk of the candy so that a given weight of pulled candy occupies considerably more space than the same weight of unpulled candy.

Prior to Dickinson's invention in about the year 1900, candy had always been pulled by hand over a hook on the wall in the manner described by plaintiff's witnesses Livermore (Rec. p. 278, fol. 312) and Hildreth. (Rec. p. 41, fol. 57.)

The work of pulling candy by hand is laborious. The candy is ordinarily so hot that it cannot be handled by a person whose hands have not been toughened to the work. The hand pulling of candy is seriously objectionable for reasons of health, because the workman's hands may not be kept clean and because the perspiration, cuticle and germs from the hands are worked into the candy. Frequently the operator's hands develop sores which incapacitate him, and some men can never get or keep their hands in proper condition to do this work. (Rec. p. 42, fol. 58.)

In spite of all these objections to the hand-pulling of candy, no machine by which candy could be pulled was devised until Dickinson made the invention of the patent in suit in about 1900, unless it be said that the paper patent to Firchau No. 511,011 dated Dec. 19, 1893, shows a machine capable of pulling candy.

Realizing fully all the difficulties of the problem, Dickinson conceived the possibility of producing a machine which would operate to pull candy effectively without danger from unsanitary conditions and at reduced cost. The machine produced by Dickinson is fully set forth in the patent in suit. As is usually the case with inventions which come early in an art, Dickinson's embodiment of his invention was crude and now seems impracticable, but immediately after it was given to the

public, it was improved upon by other inventors, notabl
Hildreth, Jenner and Thibodeau, each of whom himsel
claimed to be the first inventor. This resulted in the i
terference which has been already mentioned and will b
referred to again hereafter.

Definition of Candy Pulling.

A definition of candy-pulling as understood by Dickin
son is essential to a clear understanding of this cas
Dickinson said:—

> "The objects of my invention are first to provide
> machine which mechanically pulls candy in order t
> produce *the same result as hand pulling** and in
> better degree." (Rec. p. 223, lines 24-27.)

The hand-pulling of candy produces a bundle of paralle
fibres between which are formed air cells containing e
tangled air. These results are produced by elongatin
the candy, folding it upon itself, *again elongating th
folded mass, again folding it upon itself, and repeatin
the operations in order.* (Livermore, Rec. 287, fol. 320.
Mere stirring of the candy, or mere elongation o
stretching will not produce these results; a repeate
folding or lapping of the candy upon itself alternatin
with the stretching is necessary.

Therefore, candy pulling may be defined as the proces
of converting a plastic sugar mixture into a fibrous mas
having a definite physical structure by repeatedly elo
gating or stretching the mass and alternately lapping o
folding it upon itself. (See Livermore Deposition, Re
p. 280; Hildreth, Rec. p. 41.)

* Italics and black-face type found in quotations throughout th
brief have been supplied by counsel for emphasis.

THE MACHINE OF THE DICKINSON PATENT.

a. Its Mechanism.

Dickinson's candy pulling machine (see Rec. p. 222) is a simple affair and accomplishes the automatic pulling of candy by alternately pulling and lapping it just as the hand operator does. The mechanism by which this is done consists of three members, two movable and one stationary, which are given a peculiar motion described in the patent as "a relative in-and-out" "or figure-8 motion". The nature of this motion will be more fully explained a little later.

In the drawing of the Dickinson patent the stationary member is marked G and the two moving members are marked F and F', the two latter members being moved by suitable mechanism lengthwise of a trough in which the candy is placed. In the patent, the inventor calls the two movable pins "the candy hooks", and the stationary one "the candy puller".

The operation of the machine is simple. The candy is wrapped around the two candy hooks F, F' or laid in the trough and the machine is started. As the candy hooks pass by and move away from the stationary pin or candy puller G, the candy catches on it and is stretched or pulled. At the end of the longitudinal travel of the candy hooks F, F', their position is reversed by a catch D. This laps together the two strands of candy previously formed. The candy hooks then travel the length of the trough in the reverse direction, again pulling out the candy which catches on the candy puller G as the candy hooks pass it. This series of operations is continued until the candy is fully pulled.

b. At least three candy hooks are absolutely necessary.

For the operation of the Dickinson machine, and in fact for the operation of any candy pulling machine, at least three hooks or candy pulling members are absolutely necessary; more than three hooks can be used but a machine with less than three will not pull candy.

This proposition cannot be emphasized too strongly, particularly because the failure of the Court of Appeals for the Ninth Circuit to grasp this fact caused that court to come to its erroneous decision.

The reason why three hooks are absolutely necessary is obvious. The strand of candy must be held at each end by a pin or hook while a third pin passes between the other two, intercepting the candy and pulling it.

To realize the correctness of this proposition it is only necessary to imagine oneself attempting to pull candy by means of two sticks, one held in the right hand and the other in the left. It is obviously impossible. If the strand of candy is attached at each end to the two sticks it can be elongated once, but as neither hook can re-engage the lapped candy midway between its ends the process cannot be repeated and therefore the candy cannot be pulled, as defined in the preceding section of this brief.

It is not necessary to resort to theory on this point, since the matter was settled for the present case by the testimony of defendant's expert, Williams, in response to questions put to him by Mr. Lafferty, counsel for the defendant, as follows:—

"*Q.* But I am not asking you about candy, but as a mechanical proposition. I will ask you this ques-

tion: **If two pins, oppositely disposed, were moving in the same or opposite directions, that would not pull candy, would it?**

A. I don't see how it could.

Q. Or if three pins, or a plurality greater than two, were moving in the same direction, there would be no pulling or lapping of candy?

A. There would be no lapping or pulling.

Q. Therefore, **there must be one pin going opposite the other two at some period** of the game, or at some time of the process.

A. Yes, there must be opposite movement."

(Williams, Rec. p. 116.)

c. **The movement of the candy pulling pins of the Dickinson machine (a figure-8 or relative in-and-out movement) explained and defined.**

Dickinson also discovered that in order to produce an effective candy pulling machine, the three pins must be given a peculiar "figure-8" or "relative in-and-out" movement with relation to each other. This movement can be best understood by tracing the successive positions of each of the three pins with relation to each other during the several stages of their movements. For instance, in Figs. 2 and 3 of the Dickinson patent, it may be assumed that the candy hooks F, F' are travelling to the right. In that case, the pulling member G passes between them, then F' passes between F and G when the position of the travelling candy hook is reversed at the end of the stroke by the catch D. After that, the candy puller G again passes between F and F' as these members travel the length of the trough in the reverse direction; when the position of the candy hooks F and F' is

again shifted by the other catch D, F passes between G and F', thus completing the cycle of operation.

This cycle of operation is conveniently illustrated by the series of cuts found on the opposite page. The movement of the members may be analyzed as follows, the moving pins being designated *a* and *b*, and the stationary pin *c*:—

c passes between *a* and *b* (see Fig. 1);
a passes between *b* and *c* (see Fig. 2);
c passes between *a* and *b* (see Fig. 3);
b passes between *a* and *c* (see Fig. 4).

In Fig. 5 the cycle of operation is beginning again, the parts having reached the position from which they started as shown in Fig. 1.

This analysis shows that the terms "figure 8" and "relative in-and-out" as employed in the patent in suit mean *a motion in which each pulling member in turn passes between the other two pulling members and is in its turn one of two pulling members between which a third passes.*

All of these matters are fully set forth in the deposition of petitioner's expert Livermore in his answer to Q. 8. (Rec. pp. 285-287, fols. 318-320.)

The tremendous efficiency of this mode of operation will be instantly apparent. One cycle of movement converts the single strand of candy into one which is sevenfold, and this multiplication of the strands proceeds by geometrical progression so that at the end of six or seven cycles the hank of candy is composed of a million strands.

The foregoing discussion of the movement of the candy pulling members of the Dickinson machine has been for the purpose of ascertaining the true nature of that move-

DICKINSON'S MACHINE

MACHINE OF THE PATENT IN SUIT

Fig.1.

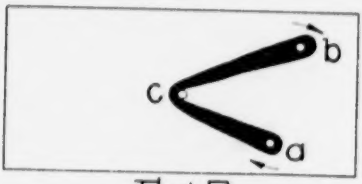

Fig.2.

Fig.3.

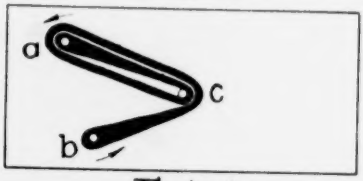

Fig.4.

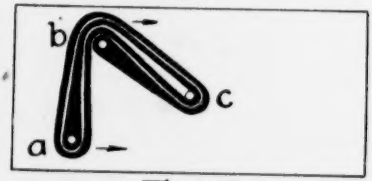

Fig.5.

Fig.1-PIN c IS ABOUT TO PASS BETWEEN PINS a AND b
Fig.2-PIN a IS ABOUT TO PASS BETWEEN PINS b AND c
Fig.3-PIN c IS ABOUT TO PASS BETWEEN PINS a AND b
Fig.4-PIN b IS ABOUT TO PASS BETWEEN PINS a AND c
Fig.5-BEGINS A NEW CYCLE.

ment, regardless of any terms or phrases by which it has been described by the patentee. In one place the patentee says "the candy is acted upon . . . along a path corresponding to what I term a figure-8". (Rec. p. 224.) Hence the expression "figure-8" movement or "figure-8" motion. In claim 1 he describes his movement as "a specified relative in and out motion of these parts for the purpose set forth". Whether or not these names are apt, or even correct descriptions of Dickinson's machine is of no importance. The expressions are mere names by which a complicated movement is conveniently designated but the questions raised by this case do not depend for their solution in any sense on the correctness of the terms employed, but solely on the identity of construction and mode of operation of the machines themselves. The Court of Appeals for the Ninth Circuit dealt too much with the correctness or incorrectness of the expression "figure-8 movement" as applied to the machines in question, and not enough with their mechanical identity. This was an important cause of the erroneous result reached by that court.

ADVANTAGES RESULTING FROM DICKINSON'S INVENTION.

Dickinson's invention of the candy-pulling machine practically ended the hand pulling of candy, and produced many economies and beneficial results.

The actual savings in money to the manufacturer who uses a candy-pulling machine are very large. No doubt they exceed $1,000 a year for each machine after due allowance has been made for all expenses incurred by its operation including the plaintiff's established license fee. (Hildreth, Rec. p. 44, fols. 60-61.)

Another important result of the use of the candy-pull-

ing machine which appeals strongly to the manufacturer is that the finished candy has considerably greater bulk than that pulled by hand. This enables him to sell a bigger stick of candy for a penny or to fill a pound box fuller so that he appears to be giving better measure.

It has been found by experience that a lower and cheaper grade of sugar or molasses may be employed in the manufacture of candy, if the candy is pulled by machine, than can be used if the candy is pulled by hand, and a better quality of candy will be produced.

Candy pulled by machinery is more uniform throughout the batch and every batch is pulled alike. The machine never gets tired and pulls the last batch in the afternoon as well as the first batch in the morning. This cannot be said of the workman who pulls candy by hand.

The final and perhaps the greatest advantage to the public is the increased wholesomeness of the product, which is no longer handled to any considerable extent during the process of manufacture. It is therefore entirely free from the dirt, disease germs, cuticle and perspiration which inevitably enter the candy during the long continued and energetic handling of the candy resulting from the hand-pulling operation. (Hildreth, Rec. p. 42, fol. 58.)

All of these great advantages are the direct result of Dickinson's invention, which transformed the pulling of candy from a laborious, expensive and unsanitary process into an easy expeditious one producing a wholesome and inviting product.

THE PRIOR ART—FIRCHAU PATENT No. 511,011.

Only one prior art patent requires any consideration, viz:—the United States patent to Firchau No. 511,011, dated December 19, 1893. (Rec. p. 269.)

This patent is a mere paper patent resurrected solely for the purposes of this suit. Although it is now more than twenty-seven years since its grant and ten years since its expiration, no machine, except models for use in court, has ever been built like it so far as the record shows or counsel is informed.

Before discussing the construction and mode of operation of the machine shown in the Firchau patent, attention is again called to the fact that the essentials of a candy-pulling machine are (a) not less than three candy pulling pins or hooks and (b) that these members shall have the peculiar relative in-and-out motion or figure-8 movement described in the Dickinson patent, and analyzed in the preceding pages of this brief.

The machine shown in the drawings of the Firchau patent comprises two disks E and E' which are rotated in opposite directions by a gear *l*. On each disk is a finger or pin *h*, *h'* which projects into a drum C in which the candy is placed. The machine therefore comprises two pins—*not three*—rotating in opposite directions on the disks E E'. The pins pass each other twice during each revolution of the disks and move in concentric circles with the same angular velocities, but *do not have* the relative in-and-out motion or figure-8 movement characteristic of the Dickinson machine. Firchau discovered neither of the fundamentals essential to a candy-pulling machine.

Since the Firchau machine contains only two pins or

hooks there can be no lapping of the candy because there is no third pin which can re-engage the candy while it is held between the other two pins. Therefore the uttermost which the Firchau machine can do is to elongate the candy, but it cannot alternately elongate it and lap it, laying the strands parallel with each other to produce the bundle of minute fibres which is the essential of pulled candy. It cannot give to the candy the definite physical structure which it is the object of a candy pulling machine to produce. Furthermore, since the two pins always move in concentric circles, and since the path of the pin H is outside of the pin H', the pin H encircles the pin H' once for each revolution of the machine and therefore, if the candy is stretched at all, it will eventually be all wound up on the inside pin.

The admission made by the respondent's expert witness Williams, that a machine having only two pins, whether moving in the same direction or in opposite directions cannot pull candy, because there would be no lapping of the candy, is conclusive of this point and disposes of this patent absolutely. Although already quoted, we quote this testimony again. The questions were asked by Mr. Lafferty, respondent's counsel:—

> "*Q.* But I am not asking you about candy, but as a mechanical proposition. I will ask you this question: **If two pins, oppositely disposed, were moving in the same direction or opposite directions, that would not pull candy, would it?**
>
> *A.* "**I don't see how it could.**"
>
> (Rec. p. 116, fol. 149.)

The Firchau patent was cited by the Primary Examiner during the prosecution of the application for the Dickinson patent, and claim 1 was deliberately allowed

over the Firchau patent as a reference. (Rec. p. 213.) At that time the Dickinson application contained the following claim:—

> 2. In a candy pulling machine in combination a series of pins or pulling members, [and] automatically acting means for causing said members to feed the candy to each other and pull the same. (Rec. p. 200.)

This claim does not differentiate from the machine shown in the Firchau patent, if two pins constitute a series. This was the position of the Examiner, and accordingly, this claim was cancelled, leaving the present claim 1 of the patent which specifies

> "a plurality of oppositely disposed candy hooks or supports and a candy puller".

In other words, the terms of the rejected claims were met by the Firchau machine which had only two pins, while the other claim which specifies three or more pins was not met by the Firchau construction and was allowed and became claim 1 of the patent in suit. Furthermore the allowed claim specified "the peculiar in-and-out motion" characteristic of the Dickinson machine, whereas the rejected claim did not contain this element.

The Patent Office was therefore clearly correct in allowing claim 1 in spite of the Firchau patent, and the only effect of this action by the Patent Office is that claim 1 must not be construed to cover a machine having only two pins, or which does not have the peculiar relative in-and-out motion of the Dickinson machine. As three or more pins and the relative in-and-out motion are absolutely essential to a candy pulling machine, the Firchau patent has no real limiting effect upon the Dickinson patent.

THE INTERFERENCE.

During the two years following Dickinson's invention of the candy-pulling machine, about 1900, and before the issue of his patent, several other applications for patents for candy-pulling machines were filed in the Patent Office by persons each of whom claimed to be the pioneer inventor. An interference was declared, claim 1 of the Dickinson patent being the issue, since that claim was for an invention disclosed by each of the applications of the parties. The actual parties to the interference were Dickinson, Hildreth, Jenner, Thibodeau and Robinson & Deiter. Two other applicants, Henry and Igou, were given an opportunity to become parties but they refused, and by so doing admitted that any patents which might be issued to them would be subordinate to the one containing the issue of the interference. To all intents and purposes, Henry and Igou were parties.

The interference was stubbornly contested step by step through all the tribunals of the Patent Office, and on appeal finally went to the Court of Appeals of the District of Columbia.

Attack was made upon Dickinson by motion to dissolve, and the questions of Dickinson's right to make this claim, of the operativeness of his mechanism, and of its patentability in view of numerous United States and foreign patents were fully discussed in brief and argument, and the issue which is now claim 1 of the patent was always and at every point upheld. Not only upon interlocutory proceedings but upon the main question of priority and all questions incidental thereto the decisions of the tribunals of the Patent Office and of the Court of Appeals were without dissent in favor of Dickinson, and after a contest extending over a period of

about five years, in which the novelty, patentability and utility of the Dickinson invention were assailed, Dickinson was adjudged entitled to the claim in issue and his patent was granted.

We quote from the opinions of the Patent Office tribunals and the Court of Appeals of the District of Columbia, which sustain Dickinson's right to the claim in issue.

The Examiner of Interferences in his decision, after quoting the issue which is claim 1 of the Dickinson patent, said:

> "Prior to 1900 the pulling of candy was done by hand in the common, well-known manner. **The issue of this interference relates to a pioneer invention,** as embodied in the earliest machines constructed for performing this pulling operation by mechanical means. **The issue is of a generic nature, broad enough to include the widely different types of machines shown in the several applications.**" **(Rec. p. 126, fol. 162.)**

The case was then appealed to the Board of Examiners-in-Chief. They said in their decision:—

> "An examination of this record leads us to the same conclusion reached by the Examiner of Interferences, who has discussed the record at length, and it is unnecessary here to repeat that discussion." . . . (Rec. p. 155, fol. 188.)
>
> "The decision of the Examiner of Interferences awarding priority of invention to Herbert M. Dickinson is affirmed." (Rec. 156, fol. 189.)

An appeal was then taken to the Commissioner of Patents in person. He said:—

> "Dickinson seems to have the elements of the ma-

chine called for by the issue, and *those elements ar mechanically operative*. It may very well be tha the other machines are improvements upon wha Dickinson shows and that they will produce bette results, but it does not follow that his machine wa inoperative. *The record furnishes no justificatio for the conclusion that Dickinson's machine wa useless*, whatever conclusion may be reached as t the comparative superiority of the various ma chines." (Rec. p. 159, fol. 193.)

The Commissioner affirmed the decision, and the cas was then appealed to the Court of Appeals of the Dis trict of Columbia. The court (Justice Morris) said:—

"We find no sufficient reason to question the cor rectness of the conclusions reached by the tribunal of the Patent Office in these interferences. We think those conclusions were fully warranted by the evi dence." . . . (Rec. p. 165, fol. 99.)

"*But this operativeness has been amply proved* Undoubtedly Dickinson's machine is not the best of those that have been offered in evidence in this case; Thibodeau's is probably an improvement on it but *it embodies the principle of the invention, and it has been successfully operated.* To that effect is the great preponderance of the evidence." . . . (Rec p. 165, fol. 109.)

We agree with the Commissioner of Patents and the other tribunals of the Patent Office that Dickin son is clearly entitled to judgment of priority of invention." (Rec. p. 166, fol. 200.)

This ended the litigation in the Patent Office, and a patent was issued to the plaintiff as the assignee of Dick-

inson containing the issue of the interference, which in this way became claim 1 of the patent in suit.

In the foregoing discussion, no detailed reference has been made to many matters which were discussed in the opinions since the opinions themselves are before this Court.

For the purpose of the present case, it is enough to point out that:

(a) the machines of the interfering applications were of widely different types, and that claim 1 was held to be broad enough to cover them all;

(b) that Dickinson's machine was held to be entirely operative although it was recognized, as counsel for the petitioner in the present case are quite willing to admit, that other machines, being improvements on it, were commercially more satisfactory;

(c) that the breadth of the issue was not affected by the prior patent to Firehan, and

(d) that Dickinson was the pioneer in the candy-pulling machine art.

This interference, resulting in the concurring decisions of eight experienced examiners and judges without a single dissent, greatly strengthens the presumption of validity resulting from the grant of the patent.*

* Walker on Patents, 5th Ed. Sec. 674. *General Electric Co.* v. *Cooper Hewitt Electric Co.*, 249 Fed. 61, 66, Court of Appeals for the Sixth Circuit, Dennison, Cir. J. *Scott et al. v. Laas et al.*, 150 Fed. 764, Court of Appeals for the Seventh Circuit, Seaman, Cir. J.

SCOPE OF CLAIM 1 IN VIEW OF THE INTERFERING APPLICATIONS.

For the purpose of making clearer exactly the scope which was intended for claim 1 by the Patent Office, it is necessary to refer to the construction of each of the machines shown in the applications of the several parties to the interference.

The Hildreth machine (see Hildreth patent No. 832,384, Rec. p. 238) had three moving pins, two (H and H') on opposite ends of an oscillating beam K and the third formed by the lower end of the swinging pendulum A. The three pins have the same motion with relation to each other as do the pins of the Dickinson patent, although none of them are stationary but all move during the operation of the machine. The candy-pulling members go through the same cycle of movement described in connection with the Dickinson patent, as follows:—

F passes between H and H';
H' passes between H and F;
F passes between H and H';
H passes between F and H'.

In the Jenner machine (see Jenner patent No. 804,726, Rec. p. 235) there are three stationary pins 1, 2 and 3, and two pins 5 and 6 which revolve on crank arms in the same direction. In this machine the cycle of operation is the same but is complicated by the fact that there are five arms altogether instead of three. The cycle of operation is as follows:—

{ 5 passes between 2 and 3;
2 passes between 1 and 5;
3 passes between 2 and 6.

5 passes between 2 and 6.

{ 6 passes between 1 and 2;
1 passes between 5 and 2;
6 passes between 2 and 5.

It is to be noted that there is no pin numbered 4 in the drawing, also that the three movements in each bracket take place simultaneously. Each of the stationary pins 1, 2, 3 is the "in between" pin only once in the cycle, while each of the pins 5 and 6 are "in between" pin twice.

In the Thibodeau machine (see Thibodeau patent No. 857,770, Rec. p. 229) the cycle is again complicated by the presence of four pins 1, 2, 3, 4, carried by two moving arms which revolve in the same direction. In this machine

2 passes between 4 and 2;
4 passes between 1 and 2;
3 passes between 1 and 4;
1 passes between 2 and 3.

In this cycle each pin is the "in between" pin in turn. This is characteristic of a four pin machine as distinguished from a three pin machine in which one pin is obliged to perform a double function.

The Robinson & Deiter machine (see Robinson & Deiter patent No. 881,442, Rec. p. 263) has one stationary pin 17, and two moving pins 14 and 19, which travel in opposite directions. Its cycle of movement is as follows:—

19 passes between 14 and 17 (see Fig. 5);
17 passes between 14 and 19 (see Fig. 6);
14 passes between 17 and 19 (see Fig. 7);
17 passes between 14 and 19 (see Fig. 8).

This is the same cycle as that of the Dickinson machine.

The Igou machine (see Igou patent No. 752,979, Rec. p. 272) is substantially the same as that shown in the Hildreth patent, in that it has two pins 5, 5 on the ends of an oscillating beam 3, and a hook or pin 9 on the lower end of a swinging pendulum 7. The only difference is that the beam 3 oscillates on a horizontal pivot and the hook or pin 9 is given a corresponding position, being at right angles to the pendulum. The cycle of movement is identical with the cycle of the Dickinson machine.

In the Henry machine (see Henry patent No. 731,681, Rec. p. 227) there is a stationary pin and two pins on revolving crank arms. Calling the stationary pin 1, and the two moving pins 2 and 3 respectively, the cycle of this machine is:—

1 passes between 2 and 3;
2 passes between 1 and 3;
1 passes between 3 and 2;
3 passes between 1 and 2.

This cycle is identical with that of the Dickinson machine.

All of the foregoing machines were held by the Patent Office and the Court of Appeals of the District of Columbia to be within the scope of claim 1 of the Dickinson patent. In the Hildreth, Igou and Thibodeau machines all of the pins moved; in the Dickinson, Henry, Jenner and Robinson & Deiter machines one or more of the pins were stationary. In the Dickinson, Hildreth and Igou machines the arms carrying some of the pins oscillate; in the Thibodeau, Henry, Jenner and Robinson & Deiter they rotate; in the Dickinson machine two of the pins travel chiefly in a straight line. In the Dickin-

son and Hildreth machines the pins are vertical, while in all the other machines the pins are horizontal.

In view of all these diversities, what then is there which is not found in the patent to Firchau and which is common to the various machines which makes them candy-pulling machines capable of repeatedly lapping and drawing the candy as does the workman who pulls candy by hand? In the first place, it is the presence of at least three pins, and, in the second place, it is the peculiar motion already defined as a motion in which each pulling member in turn passes between the other two pulling members and is in its turn one of two pulling members between which a third passes. Each of these features is found in all of the applications which were in interference, but neither of them was found in the patent to Firchau.

The use of the word "relative" in the claim was well advised. Dickinson believed himself to be the pioneer inventor and he realized clearly that others might attempt to evade his patent by clothing the invention in a guise so different that the outward appearance might mislead. He realized that it made no difference whether the pins all moved or part of them were stationary as long as they had *relative* motion. He knew that the effect was the same whether you back the horse into the shafts or pull the shafts up to the horse. So he put the word "relative" into the claim.

The claim is as broad as the invention and covers all of the diverse machines of the several parties to the interference. It expressly covers every machine which has a pair of oppositely disposed candy hooks or supports and a candy puller and which has Dickinson's specified relative in-and-out motion of these parts.

THE DICKINSON PATENT A BROAD PATENT.

But whether the Dickinson patent is a "pioneer" patent or not, it cannot be denied that it is one of generic character. Whether or not the art of machine candy-pulling started with Dickinson, it is indisputable that the type of machine which has three or more pins operating with the peculiar Dickinson sequence did originate with the Dickinson patent. Therefore the Dickinson patent is generic of that type of machine which has three or more pins moving with the peculiar sequence of in-and-out motion.

But even the presence of a prior patent in an art does not prevent the patent which was the true foundation of the successful development of that art being held to be the pioneer in the art. Many pioneer patents have been preceded by other patents or devices in the same art.

In *Sessions* v. *Romadka*, 145 U. S. 29, 45, the patent in suit was held to be a pioneer patent although preceded by several prior devices or patents.

In the *Telephone cases*, 126 U. S. 536, Bell's telephone was preceded not only by mechanical telephones composed of a cord stretched between a transmitter and a receiver, and by attempts at electrical telephones in which the operation was not dependent upon undulations in the electric current, yet he was held to be the pioneer inventor.

In the *Mergenthaler Linotype case*, 57 Fed. 502, it appears from the opinion that Mergenthaler had been preceded by Wescott, Morgan and Gally, but the Court treated the patent as a pioneer patent.

In *Scott* v. *Fisher*, 145 Fed. 915, the Court stated in its opinion that the only prior limiting patent was the patent to Cooper & Ford, but nevertheless said "it may

therefore fairly be said that he [the patentee of the patent in suit] fulfilled the requirements of a generic invention."

Instances of this kind could be multiplied, but when all is said and done, the question of whether or not a patent is a pioneer patent depends on whether the true development of the art began with the invention in question.

That the art of candy pulling by machinery had its origin with Dickinson is not disputed in this case. Judge Rose in the decision in *Hildreth* v. *Lauer & Suter Co.* said:—

> "Before Dickinson perfected his invention men had wanted a candy-pulling machine. He found out how one might be made." (Rec. p. 180, fol. 214.)

Earlier in his opinion he said:—

> "That conception, instead of being inoperative, is in operation in every one of the hundreds of candy-pulling machines now in use. *It is operating today to pull almost all the candy which is pulled in these United States.*" (Rec. p. 179, fol. 212.)

The Firchau patent was granted in 1893. No machine was built or used under this patent and it contributed nothing to the development of the candy-pulling machine art. It suggested nothing to other inventors. The art of candy-pulling machinery, if it was an art at all at this time, lay dormant until the year 1900, when Dickinson made his invention. Instantly the art sprang into life, and machines like those shown in the patents to Henry, Thibodeau, Igou, Jenner, Robinson & Deiter and others, all of which were improvements on the Dickinson machine, made their appearance on the market. Since that time probably 90 per cent of all pulled candy has been

and is pulled by machines embodying Dickinson's inve tion, the small remainder being pulled by hand. Thi development was the direct result of Dickinson's inve tion.

Can it be said that a patent such as Firchau's, whic has lain dormant for twenty-seven years and which neve contributed anything to the development of the art, i any way affects Dickinson's pre-eminent position?

DICKINSON PATENT NOT A MERE PAPER PATEN

Neither is the Dickinson patent a mere paper paten The following types of machines have been held to b embodiments of Dickinson's inventions: Thibodeau Igou, Henry and Jenner.

Mr. Hildreth testified, and his testimony is uncon tradicted, that he has built and has leased to others t be used between three and four hundred machines of th Thibodeau and Henry types. (Hildreth, Rec. p. 45, fo 61.)

Therefore, whether or not the Dickinson machine is pioneer patent, it is established that the invention of th Dickinson patent has gone into widespread use and ha revolutionized the candy-pulling art.

THE DEFENDANT'S MACHINE—LANGER PATENT No. 1,232,697 (Rec. p. 298).

Respondent's alleged infringing machine is built i accordance with the patent to Langer No. 1,232,69 July 10, 1917, application filed October 9, 1916, abo ten years after the grant of the patent in suit. Th patent is owned by the respondent.

In this machine, there are two stationary candy pu ing members which are designated in the Langer pate

8 and 9, and a travelling candy puller 12, which travels successively about the peripheries of two tangent disks at the centres of which the stationary pins 8 and 9 are located. The path of movement of the moving pin 12 about the two circles is a true figure 8.

In his specification Langer says:—

> "My invention relates to candy pulling machines, and more particularly to a machine adapted to automatically pull candy by means of *a floating puller which is carried through a course of travel corresponding in form to the figure 8, and around fixed supporting pins arranged concentrically within the two circular portions of said figure 8*, whereby the candy is pulled by said floating puller and alternately carried thereby around said fixed supporting pins." (Langer patent, Rec. p. 299, lines 9-19.)
>
> "This movement laps the candy around the pin 9, then stretches it and laps it around the pin 8, and then stretching it again laps it around the pin 9, pulling and stretching the candy as the floating puller 12, is carried through its course of travel, *corresponding to the figure 8*." (Rec. p. 301, lines 1–7.)

The patent, therefore, describes the movement of the moving pin as a figure-8 movement exactly as does Dickinson in lines 19–22, Rec. page 224, when he says:—

> "In either case the candy is acted upon in a manner and by means of the shifting hook along a path corresponding to what I term a figure '8'."

Since both Dickinson and Langer have adopted the same term to describe the movements of the respective machines, it only remains to be determined whether the

two movements thus described are in fact substantially the same; in other words, to make sure that there is substantial mechanical identity between the machines rather then mere identity of the phrases employed in describing them.

The nature of the movement of the Dickinson machine has already been fully analyzed and it has been shown that the relative movement of the three candy-pulling members is such that each in turn passes between the other two and is in turn one of two pins between which the third passes; furthermore, that the stationary pin is the passing or "in between" pin twice as often as are the other two pins. The movements of the Dickinson machine have also been analyzed as follows:—

c passes between *a* and *b*;
a passes between *b* and *c*;
c passes between *a* and *b*;
b passes between *a* and *c*.

In the defendant's machine the movement is exactly the same. If the two stationary pins designated 8 and 9 in the Langer patent are called *b* and *a*, and the moving pin 12 of the Langer patent be called *c*, and if we begin the cycle of movement when the travelling pin is below the line between the two stationary pins, the corresponding analysis of the movement will be as follows:—

c passes between *a* and *b*;
a passes between *b* and *c*;
c passes between *a* and *b*;
b passes between *a* and *c*.

From the foregoing it is apparent that, in spite of the difference of appearance, there is a substantial identity of construction and mode of operation between the Dick-

inson machine and the machine shown and described in the Langer patent.

ALLEGED INOPERATIVENESS OF THE DICKINSON MACHINE.

While the Court of Appeals for the Ninth Circuit in reaching its decision decided the case mainly on the ground that the respondent's machine, built in accordance with the Langer patent, was not an infringement of claim 1 of the Dickinson patent, when considered in view of the patent to Firchau, nevertheless the Court discussed at length the question of the alleged inoperativeness of the Dickinson machine and was greatly influenced by the conclusion which it reached that the Dickinson machine was inoperative.

In reaching this conclusion, the Court of Appeals made three fundamental mistakes:—

(1) It did not accept the conclusions the trial judge who saw and heard the witnesses on questions of fact as to which the Court of Appeals expressly states that the evidence was doubtful.

(2) Being doubtful as to the question of inoperativeness the Court of Appeals did not resolve the doubt in favor of the patentee, as it should have done.

(3) The Court of Appeals adopted an erroneous test as to what constitutes operativeness of a patent in suit, the test which it adopted being diametrically opposed to the rules laid down by this Court.

The Facts as to Operativeness.

All the testimony in this case relating to the questi of operativeness was taken in open court before H Honor District Judge Wolverton. Only two witness testified on this matter, namely Herbert L. Hildreth, t plaintiff-petitioner herein, and Henry Ross on behalf the defendant-respondent.

Mr. Hildreth is a manufacturer of molasses cand having been in the candy business for more than thir years. He has a factory having a capacity of four to of pulled candy per day. (Rec. p. 40, fol. 55.)

Mr. Hildreth testified as follows:—

"*Q.* Did you ever operate, or see operated, t Dickinson machine—full operation?

A. Yes, I had one in my factory.

Q. Where is that machine now?

A. It is in my factory." (Rec. p. 60, fol. 80.)

On cross examination he testified:—

"*Q.* Mr. Hildreth, do I understand your dire testimony to be that the Dickinson machine is commercial success?

A. It never was put out commercially.

Q. Never used it commercially at all?

A. No, sir.

Q. Well, have you used it to any extent whats ever?

A. No great amount; no sir.

Q. To what amount have you used it?

A. Well, we have worked some on it and tried

Q. Well, by working some and trying it, y mean just for experimental purposes?

A. Oh no. The Dickinson machine was sent

originally by Mr. Dickinson. We took it to our factory, and Mr. Dickinson came with it.

Q. Well, do you mean to tell the court that you actually used it there in making candy?

A. We had it there in the factory perhaps a week, and maybe two weeks. But it didn't pull candy to suit me. *It would pull it some, but it wouldn't pull it as we wanted our candy pulled.*" (Rec. p. 64, fol. 85.)

Also:—

"*Q.* Oh there was where the misunderstanding arose. Then you say there was a machine built? There has been one machine built that is a substantial mechanical embodiment of the machine described in the Dickinson patent?

A. Yes, more than one.

Q. Well, in all respects are these machines like the Dickinson patent?

A. Yes sir, as far as I know.

Q. What?

A. As far as I know.

Q. Now, how many machines of that description have been built?

A. Well, three to my knowledge.

Q. Are they in existence today?

A. One of them is. (Rec. p. 73, fol. 97.)

. . . *Q.* So far as you know, then, there is but one machine in existence that embodies in form the subject matter of the Dickinson patent?

A. That is built to look just like the patent.

Q. Where is that machine now?

A. In my factory.

Q. *Will it operate?*

A. *Yes, sir.*

. . . *Q.* Have you ever used it in practical oper
tion?

A. *We have.*

Q. To what extent?

A. To pull candy. We made a change.

Q. How much candy?

A. Well, we pulled sixty or seventy pounds at
time. We changed that machine a little bit, tha
long pull there, we shortened up that pull, an
speeded the machine. This is after it was in n
factory, a number of years after I bought it. I
doing that, *it pulls candy all right.*

Q. Would it pull candy as shown in the patent?

A. **It will pull it some, yes; but it don't pull it**
well as our machine pulls it.

Q. Will it pull it practically?

A. Well, practically would be so it would be com
mercial.

Q. Well, would it pull it commercially then?

A. Well, not the way we pull our candy. It wa
not pulled enough. **It would pull it, but the strok**
was too long. We shortened up the stroke, and made
all right. . . ." (Rec. pp. 74 and 75.)

"*Q.* And that would not pull candy until yo
changed it?

A. Oh, yes, it would.

Q. It would not pull it commercially?

A. Well, no, it would not pull it, **not as well as w**
wanted candy pulled. . . ." (Rec. p. 75.)

"*Q.* You say you would have made changes tha
would have made it a commercial success?

A. *Simply shortened up the stroke. It does n*
affect the principle of the thing at all, any more tha
opening a door half way to let a big man through

he cannot get through; you open it up wide and he can get through." (Rec. p. 75.)

Hildreth's testimony must be taken as a whole. When so taken, certain facts are clear, viz.:—that the machine would pull candy some; and that a mere shortening of the distance travelled by the pins along the trough was all that was necessary to make the machine a commercial success. With the change of a single dimension, the machine became commercially operative, but without any change whatever and in exactly the form shown in the drawings of the patent the machine was still operative —*it would pull candy some.*

In opposition to this testimony there was nothing but the opinion of one witness, Henry Ross, as to whose qualifications as an expert the following colloquy between the respondent's counsel and the court took place—

Court. Are you calling this man as an expert now on the mechanical operation of these machines?

Mr. Atkins. No, on candy manufacture; candy-maker—expert candy-maker.

Court. I don't think he is helping the Court a particle.

Mr. Atkins. You don't?

Court. No, I don't think so.

Mr. Atkins. I don't want to burden the Court, I am sure.

Court. This man is not an expert on the mechanical operation of a machine. If you want to inquire of him about the texture of the candy, and how it is produced, and the heat required, etc., if you think it is at all material to this case, you can inquire into that. I don't see that that is very material." (Rec. p. 120, fol. 155.)

This witness who had never had any experience with the Dickinson machine and who said "*that one* (Dickinson) *I have never seen till I came here*" (Rec. p. 118, fol. 152), criticised the Dickinson machine as follows:—

> "It don't let air enough in it. It hasn't got the motions to it. It lays flat on the floor there, on the bottom of the trough, and it certainly don't get the air around. In any of the pulling-machines, as it is in existence now, the air is from all sides. It absorbs the air, knocking it around, but this one don't." (Rec. 119, fol. 153.)

This was all the testimony on the subject of operativeness, but there was an actual demonstration in court of the ability of the Dickinson machine to pull candy. Counsel for the plaintiff had in court a small hand-operated model of the Dickinson machine which was not offered in evidence being used merely as a chalk, although it was referred to in the record on page 103 as "Plaintiff's Exhibit Model of the Dickinson machine". Mr. Lafferty, counsel for the defendant first put too large a piece of candy on this machine and attempted to show that it would not work. Mr. Dike, counsel for the plaintiff, then put a piece of candy of proper size on the machine and operated it on the desk in front of Judge Wolverton showing the positions of the strands of candy during the successive stages of movement and demonstrating clearly that even this small model would pull candy. At the same time he compared the several positions of the candy with the corresponding positions of the candy on defendant's Langer machine. This demonstration is reported on page 103 of the record as follows:—

> "*Mr. Lafferty.* If the Court please, at the same

time we desire, with part of the same candy, to make a demonstration upon this model, *plaintiff's exhibit model of the Dickinson patent,* to show that it will not pull candy. In this machine the movement is in a continuous direction. This other machine reverses and goes back in exactly the opposite direction. (Counsel demonstrates working of model.)

Mr. Dike. If the Court please, may I show the Court this?

Court. Yes.

Mr. Dike. I don't know whether this is the right amount or not (referring to candy materials), but perhaps it will illustrate what I want to show. You see that is making now the V-shaped hank which the witness referred to in the testimony; one end starting here, the other going from here to here. Now the reversing is going to take place, and the two strands of candy are lapped together. Now it is being converted into the V-shaped strand again. (Counsel illustrates operation.) Now, I want this to go through one more operation, for the sake of showing the relation of the pins. It makes no difference which is stationary. The lapping is now taking place. Now, this pin is going to pass between those two. (Illustrates on model.) Now (referring to machine Exhibit 'C'), I want to point out the fact that this pin is between those two. Now, this pin is between those two. This pin is about to pass between those two. Now this pin has just passed between those two. Each time making that V-shaped strand. I want to call attention to the peculiar V-shape which is identical with that you have seen in the Dickinson machine. There is the V-shape here again. That illustrates it very well just

in that position, as showing how the lapping takes place.

Court. Very well; *I think I understand that.*"

Judge Wolverton took into consideration all the evidence before him, believing the evidence of his own eyes and Mr. Hildreth's testimony and disregarding Mr. Ross' opinion which was clearly based on insufficient knowledge of the subject. Judge Wolverton said:—

"Aside from the presumption that the patent affords that the Dickinson machine is operative, the testimony here satisfactorily shows it to be a fact. Complainant, the present owner of the patent, had and still has one of the machines in his factory. He testifies that he has used it in practical operation, and that, while as originally constructed, it did not pull candy satisfactorily, yet by shortening the reach of the pull and speeding up the mechanical apparatus for moving the pins, it did the work all right, and would pull candy commercially. The change in construction to speed up the operation in no way affected the principle involved by the invention. **A model has been introduced in evidence showing the mechanical operation of the machine, and it is within itself a demonstration that it pulls candy.** . . ."

"Can there be any doubt about a device of the kind, and thus operated, stretching or pulling the substance mechanically? Surely there can be none. If none, what becomes of the alleged inoperativeness of the Dickinson device? By causing the two objects to move in opposite directions past the intervening or stationary object, and to be reversed at the respective extremities, the substance will again be caused to be twice stretched or pulled, in the same

way as above indicated, and thus will be completed a cycle in operation of the Dickinson device. The continued operation consists in repeating the cycles in movement of the moving objects in relation to the stationary object. No further argument is necessary to convince one that the device is mechanically operative for pulling candy in some form. It may not be the best device possible for the purpose, but it is self-evident that it will pull candy." (Rec. p. 21-3.)

The Court of Appeals for the Ninth Circuit however reversed Judge Wolverton, summing up the matter of operativeness with the statement (Rec. p. 336)—

"The testimony leaves it doubtful whether the Dickinson machine is operative."

The Court of Appeal's First Mistake—It Disregarded the Finding of Fact of the District Court.

The Court of Appeals' first mistake was in disturbing the finding of fact made by the trial Judge who saw and heard the witnesses, particularly as the testimony left the matter doubtful in the minds of the Court of Appeals.

The proposition that findings of fact made by a trial court which saw and heard the witnesses are conclusive on an appellate court is too well established to admit of an extended citation of cases.

This Court has stated this rule in *Dooley* v. *Pease*, 180 U.S. 131, as follows—

"Where a case is tried by the court, a jury having been waived, its findings upon questions of fact are conclusive in the courts of review, it matters not how convincing the argument that upon the evi-

dence the findings should have been different." Citing *Stanley* v. *Supervisors*, 121 U. S. 547.

This Court has expressly applied this rule to patent cases. See the statement of Mr. Justice Holmes in *Adamson* v. *Gilliland*, 242 U.S. 350, 353—

> "Considering that a patent has been granted to the plaintiff, the case is pre-eminently one for the application of the practical rule that so far as the finding of the Master or Judge who saw the witnesses 'depends upon conflicting testimony, or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding it must be treated as unassailable.' *Davis* v. *Schwartz*, 155 U.S. 631, 636."

In *United States* v. *United Shoe Machinery Co.*, 247 U. S. 43 (37), this Court (Mr. Justice McKenna) said:—

> "The contentions could not well be more antagonistic, upon each of which there was conflicting testimony, and the important fact is to be borne in mind that it was given in open court except as to certain contentions about patents (their scope and validity.) The fact justifies deference to the findings of the trial court. *Adamson* v. *Gilliland*, 242 U.S. 350, 353."

See also:—

St. Louis v. *Rutz*, 138 U.S. 226, 241.
Runkle v. *Burnham*, 153 U.S. 216, 225.
Continental v. *Eastern*, 210 U.S. 405, 416.
Lillie v. *Dennert*, 232 Fed. Rep. 104, 107.
Chautauqua Institution v. *Zimmerman*, 233 Fed. Rep. 371, 375.

See also the decisions of the Court of Appeals for the Ninth Circuit in *National Surety Co.* v. *Globe Grain & Milling Co.*, 256 Fed. 601, 602; *and Butte & Superior Copper Co.* v. *Clark-Montana Realty Co.*, 248 Fed. 609, 616.

We respectfully submit that the Court of Appeals for the Ninth Circuit in the case at bar flagrantly disregarded a well established rule of procedure and that the decision should be reversed on this ground if for no other reason.

If Operativeness was in Doubt, the Doubt Ought to Have Been Resolved in Favor of the Patentee.

As previously pointed out, the Court of Appeals for the Ninth Circuit said on the question of operativeness of the Dickinson machine—

> "The testimony leaves it **doubtful** whether the Dickinson machine is operative."

Leaving out of consideration that the conclusion of the trial court on questions of fact ought to have been followed, the Court of Appeals for the Ninth Circuit disregarded another well-established principle of law when it held the machine of the patent in suit inoperative upon evidence which the court itself said left the matter doubtful.

The grant of a patent by the Patent Office raises the presumption that the patent is both new and useful,[1] and this includes a presumption that the thing shown in it is operative, since the argument that the machine of a patent is inoperative is merely an attack on its utility. The presumption arises from the fact that the Exam-

[1] *Lehnbeuter* v. *Holthaus*, 105 U.S. 94.

iners of the Patent Office are persons skilled in t
art to which the patent belongs and that they have e
amined the art and considered the construction a
mode of operation of the patented device carefully befo
granting the patent, so that the patent issues support
by the findings of learned men that the patent is for
new and useful improvement.[1] This presumption
strengthened where, as in the case at bar, a patent h
been the subject of a bitterly contested interference
the Patent Office during which every possible objecti
to the issue of the patent has been presented to the va
ous tribunals of the Patent Office.[2]

The Dickinson patent was attacked in the Patent O
fice on the ground of inoperativeness. The Commi
sioner of Patents said (Rec. p. 159):—

> "It was further urged then, as it is now, th
> Dickinson's device was inoperative as a candy-pu
> ing machine. The mechanism in Dickinson's devi
> will undoubtedly operate as described in his speci
> cation, but it is contended that it will not produ
> the effect on the candy which follows from pulli
> it and which follows from the use of the machines
> the other parties. . . . The record furnishes
> justification for the conclusion that Dickinso
> machine was useless, whatever conclusion may
> reached as to the comparative superiority of t
> various machines."

Therefore, in the case at bar, the patent in suit is s
ported by an exceptionally strong presumption in fa

[1] *Troy Laundry Machinery Co., Ltd.*, v. *Columbia Mfg. Co.*,
Fed. 787, 789.

Railroad Supply Co. v. *Hart Steel Co. et al.*, 222 Fed. 261, 274

[2] *General Electric Co.* v. *Cooper Hewitt Electric Co.*, 249 F
61, 66.

of its validity, and the Court of Appeals, being, as it said, in doubt, ought to have resolved the doubt in favor of the patent. The fact that, in the last analysis, the Court of Appeals based its decision on the question of infringement does not change this conclusion, since the Court of Appeals was influenced by its views as to operativeness in reaching its conclusion on infringement.

Law as to What Constitutes Inoperativeness of a Patent in Suit.

In considering this question, the Court of Appeals failed to distinguish between the inoperativeness of the machine of a patent in suit and the inoperativeness of the machine of an anticipating patent. Of the cases cited by it *General Electric Co.* v. *Wise*, 119 Fed. 922; *Hale & Kilburn Mfg. Co.* v. *Onconta G. R. & S. Ry. Co.*, 129 Fed. 598; *Bowers* v. *San Francisco Bridge Co.*, 91 Fed. 381, 416; *Chadeloid Chemical Co.* v. *Frank S. DeRonde Co.*, 146 Fed. 988, deal exclusively with the operativeness of an anticipating device and therefore are not in point.

Although *Royer* v. *Coupe*, 29 Fed. 358, cited by the Court of Appeals, was reversed by this Court in *Coupe* v. *Royer*, 155 U.S. 565 (574), this Court seems to have taken the same view on the question of operativeness as did the lower court and said:—

> "But this apparent inconsistency in the two instructions will disappear if we understand the latter to be based on the suggestion that the plaintiffs' patent would be void if it were without utility. A patented machine **that will not do what it is intended to do** could not sustain an action against one who was shown to use a successful and operative machine."

This Court thus affirmed on this point the trial court which had charged the jury as follows (573):—

"you are not to consider whether one machine makes more trouble than the other, whether one makes work more uniform than the other and more desirable in the market, whether one is better able to perform the work, etc., etc. . . . These considerations are of no consequence. To put it more shortly, the question to be determined by you is not which of these is the better machine, but simply and solely, **will a machine made with a vertical shaft do the work at all?**"

Note: The jury found for the plaintiff. (29 Fed. Rep. 358.)

The test of operativeness laid down by this Court is whether the machine will do the work at all. If it will do it at all, the machine is operative, even if it works badly and imperfectly.

The opinion of the Circuit Court of Appeals for the Ninth Circuit in the case at bar is absolutely at variance with the decision of this Court in *Telephone Cases*, 126 U. S. See particularly pages 535 ff:—

"It is quite true that when Bell applied for his patent he had never actually transmitted telegraphically spoken words so that they could be distinctly heard and understood at the receiving end of his line. . . . The particular instrument which he had and which he used in his experiments did not, under the circumstances in which it was tried, reproduce the words spoken, so that they could be clearly understood; but the proof is abundant and of the most convincing character, that other instruments, carefully constructed and made exactly in accordance with the specifications, without any additions whatever have operated and will operate

successfully. . . . *If one succeeds, that is enough, no matter how many others fail.* . . . The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation. This Bell did."

In *Mergenthaler Linotype Co.* v. *Press Publishing Co.*, 57 Fed. 502, 505, Judge Coxe of the Southern District of New York proceeded upon the assumption that the patent is a broad patent, although, as previously stated, there existed certain prior art, and said:—

"Their contention proceeds upon the untenable proposition that the machine which produced the 'linotype' was valueless because it did not produce an absolutely perfect 'linotype'. Such a proposition, if sustained, would condemn to obscurity some of the greatest works of human genius. A great poem may be marred because the meter halts at times, but it is a great poem still. Even the masterpiece of Rubens was improved by the touch of his pupil, Van Dyck. It is true that the first specimens produced by the Mergenthaler machine are wanting in 'perfect justification'. They did show, however, that a great advance had been made in the art of printing even though the words were not spaced apart so as to be mathematically uniform at the extreme ends. The defect was one that was at once suggested by printers, and the patentee and others immediately set to work to remedy it. This

was not a difficult task and was soon accomplished. As was said by the public printer in writing of the invention as early as May, 1884:—

'Even in this short time during which I have been familiar with the matter, the progress made has been wonderful, and in my judgment, but little remains, and that merely mechanical, to make the invention perfect.'

"Concede that the machine when first produced was not perfect and that to Schuckers belongs the credit of producing the spacers which made it perfect. Cui bono? *It would certainly be a novel doctrine to deny to an inventor the fruits of a broad invention because the machine which first embodied it was rudimentary in character and failed to do as good work as improved machines made subsequently. None of the great inventions could survive such a test.* Ten years after the invention of Howe, the machine first made by him would hardly have satisfied the least exacting sewing woman. The Dodds and Stevenson locomotive would, only a short time after its construction, have been discarded as behind the age even by the savages of Tasmania. The telephone of Bell is not the perfected telephone of commerce, the Morse telegraph is looked upon today as an interesting antique. And yet, it would be an unheard of proposition to withhold from these illustrious men the credit they deserve because their machines were crude at first and were improved afterwards."

See also

Rogers Typograph Co. v. *Mergenthaler Linotype Co.*, 64 Fed. 799, 803.

In *Underwood Typewriter Co.* v. *Typewriter Inspection Co.*, 177 Fed. 230, 234, the court held that a serious defect in the construction of the device of a patent in suit did not make it inoperative.

Judge Hough's statement in *Engineer Co.* v. *Hotel Astor*, 226 Fed. 779, referred to by the Court of Appeals for the Ninth Circuit in its opinion, contains the best definition as to what constitutes operativeness of the machine of a patent in suit. Judge Hough said:—

> "A device need not be perfect in order to escape the charge of inoperativeness. . . . The test of operativeness is to ascertain whether the patented device does (even lamely and imperfectly) perform the acts claimed for it in the method described and (perhaps) for the reasons given."

The Court of Appeals for the Ninth Circuit distinguished this case on the ground that Judge Hough found a substantial performance. In the case at bar the machine certainly worked somewhat and there was certainly sufficient performance to have required the Court of Appeals to conclude that the case fell within the rule laid down by Judge Hough.

In *Dalton Adding Machine Company* v. *Rockford Milling Machine Co.*, 253 Fed. 187, Judge Sanborn said:—

> "Imperfections in a machine, not affecting the substance of the invention, and which are curable by mechanical skill do not render the patent inoperative."

He then cites the Telephone Cases and quotes from Judge Hough's opinion in *Engineer Co.* v. *Hotel Astor*, *supra*, and continues:—

> "The Helmick invention meets this test. It de-

scribes a machine absolutely new in the art, and is clearly a primary invention. Such an invention should not be held inoperative without ample proof. **The presumption of validity is much stronger than in the ordinary case.** *Van Schmidt* v. *Bowers*, 80 Fed. 121, 25 C. C. A. 323; *Scott* v. *Fisher*, 145 Fed. 915, 76 C. C. A. 447. **It requires but slight evidence of successful operation to avoid the defense of want of utility of a patent sued on.** *Thayer* v. *Wold*, 142 Fed. 776; *Wold* v. *Thayer & Chandler*, 148 Fed. 227, 78 C. C. A. 350."

In the case at bar there was certainly more than the slight evidence of successful operation which the Court of Appeals for the Eighth Circuit says is necessary to avoid the defense of want of utility.

A case nearly like the present is *Scott* v. *Fisher*, 145 Fed. 915, 922, decided by the Second Circuit. In that case it was argued by the defendant and found by the court below that the Bellis invention was not a meritorious one because the machines were inoperative or impractical for successful commercial operation. It appeared, however, that the defects could be remedied by an enlargement of the dial of the knitting machine. The court said:—

"We are unable to see, therefore, how it affects the meritorious character of the invention. It is frequently a characteristic of generic inventions that their first embodiments work imperfectly, and where the imperfections may be remedied, as in this case, by what amounts to a mere readjustment of relative sizes, such change does not affect the character of the underlying creative conception. In these circumstances, the majority of the court is of the

opinion that the decree of the court below as to the defendant corporation must be reversed, with costs."

Another statement of the true rule as to operativeness, and among the best is to be found in Judge Lacombe's charge to the jury in *International Tooth Crown Co.* v. *Hanks Dental Association*, 111 Fed. Rep. 916, 920,—

> "Therefore it is for you to determine whether or not there is any utility in the invention. There has been a great conflict of testimony upon that point, . . . You may be very much helped in disposing of all this testimony by one or two considerations. *The first of them is that, if it is useful at all, that is sufficient. If there is any utility in it, that is sufficient to support the patent. The measure of utility does not make any difference.* It would be a perfectly valid patent if a device is a useful one, although 50 or 100 others might be very much more useful, and although improvements upon the device might make it more useful than it was before. Nor is it necessary that a continuation of usefulness be shown, or that it must be so for a long period of time. That is not essential. *If it is useful at all, it sufficiently meets the requirements of the statute that the invention must be a new and useful one to warrant the granting of the patent.*"

The Patent Office, the Court of Appeals for the District of Columbia, and the Court of Appeals for the Fourth Circuit on the Question of Operativeness.

The question of operativeness of the Dickinson machine was fully considered in the Patent Office. On the

appeal to the Commissioner of Patents in person the question was argued and the Commissioner said in his opinion:—

> "Dickinson seems to have the elements of the machine called for by the issue, and those elements are mechanically operative. . . . **The record furnishes no justification for the conclusion that the Dickinson machine was useless,** whatever conclusion may be reached as to the comparative superiority of the various machines." (Rec. p. 159, fol. 193.)

The Court of Appeals for the District of Columbia made a similar statement:—

> "So there is no reasonable ground for controversy between Dickinson and Thibodeau other than the question of the operativeness of Dickinson's machine. **But this operativeness has been amply proved.** Undoubtedly Dickinson's machine is not the best of those that have been offered in evidence in this case; Thibodeau's is probably an improvement on it, but it embodies the principle of the invention, and it has been successfully operated. To that effect is the great preponderance of the evidence." (Rec. 165, fol. 199.)

As has been stated, Judge Rose's opinion in *Hildreth* v. *Lauer & Suter Co.* was adopted by the Circuit Court of Appeals for the Fourth Circuit as its opinion. Judge Rose said (Rec. p. 178 fols. 212, 213):—

> "The defendant contends that the Dickinson patent is invalid because it is for an inoperative device. In the interference proceedings the same contention was made by the present plaintiff. Every one of the Patent Office boards and officials

before which the interference came decided that it was not well founded. The Court of Appeals of the District of Columbia agreed with them. The thorough investigation which Dickinson's application then received as a result of that long-drawn-out contest in which this very issue was repeatedly raised, adds unusual weight to the ordinary presumption of validity which attaches to every patent. In this connection also it is necessary to keep in mind for what invention this claim was granted. As already pointed out, the great thing which Dickinson found out was that oppositely disposed candy hooks and a candy-puller given a specified in and out motion would move candy along a figure 8 pathway and would thereby pull it. **That conception, instead of being inoperative, is in operation in every one of the hundreds of candy-pulling machines now in use. It is operating today to pull almost all the candy which is pulled in these United States.** He complied with the requirements of the law by devising a machine which would give this in and out motion to the hooks and puller and would move the candy along the designated road. It is true that it is highly doubtful whether with his machine candy could be pulled for commercial purposes.* The form of telephone which Bell made was valueless for practical use. Dickinson was able to see what had for years been hidden from all others. His discovery was illuminating. His execution poor. In patent cases it has been often noted that persons of the most bril-

* *Note.* This statement is squarely at variance with the opinion of the Ninth Circuit—"If it is not susceptible of use commercially, it has no utility, for it is obvious that such a machine can have no utility except in the commercial field". Rec. p. 338.

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liant conceptions are sometimes the poorest mechanics.

"In view of the action of the Patent Office and of the Court of Appeals of the District of Columbia, of the facts disclosed by this record, and of the principles laid down in many well considered and authoritative decisions, the defense of inoperativeness cannot be sustained.

Telephone Case, 126 U.S. 535.
Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. 845.
Van Schmidt v. *Bowers*, 80 Fed. 149.
Packard v. *Lacing Stud Co.*, 70 Fed. 67."

In view of the concurring decisions of the Patent Office, the Commissioner of Patents, the Court of Appeals for the District of Columbia, Judge Rose of the Maryland District, and the Court of Appeals for the Fourth Circuit, we respectfully submit that the Court of Appeals for the Ninth Circuit was in error in not giving proper weight to the presumption of validity resulting from the grant of the patent and the previous adjudication in its favor.

The Court of Appeals' Erroneous Test of the Question of Operativeness of a Patent in Suit.

After discussing the question of operativeness and referring to some cases, the Court of Appeals for the Ninth Circuit laid down the following as the test of operativeness of the machine of the patent in suit.

"If it is not susceptible of use *commercially*, it has no utility, for it is obvious that such a machine can have no utility except in the *commercial* field."

This test is contrary to the rules laid down by this Court in previous cases. As explained previously in connection with *Coupe* v. *Royer,* this court accepted the ruling of the District Court in charging the jury that "a machine was operative *if it would do the work at all*".

Likewise in the Telephone cases, *supra,* the court sustained a patent even though as it stated in its opinion the device was so crude that the inventor had not succeeded in transmitting speech with the instrument prior to the filing of the application. Certainly Bell's instrument in the Telephone cases was far less capable of use commercially than was Dickinson's machine in the case at bar.

See also the phraseology of this Court in *Railway Co.* v. *Sayles,* 97 U. S. p. 560.

> "It is useless to argue that this brake was an imperfect one, or that it worked far less satisfactorily than the Tanner or other brakes. *It did work;* and under favorable circumstances worked as well as the most improved form of brakes."

While it is true that this Court was speaking of the question of operativeness of an anticipating device, the language states the rule of law in question.

The doctrine of the Supreme Court in these cases is clearly founded in reason. Great inventions like all great things must have small beginnings, and it is the object of the patent laws to promote public welfare and stimulate the development of beneficial inventions by protecting such small beginnings. The test laid down by the Court of Appeals for the Ninth Circuit imposes a doctrine of perfection wholly at variance with the spirit of the patent laws, and the decisions of this court. If an inventor is required to bring his invention instantly to the

state of perfection required by the Ninth Circuit, he loses the protection and stimulation to be derived from the grant of a patent at the very time when this assistance is most needed, and, since the interest of the inventor is the interest of the public, the public will thus be deprived of benefits which it would otherwise have received.

THE COURT OF APPEALS ON THE QUESTION OF INFRINGEMENT.

The Court of Appeals for the Ninth Circuit reversed the District Court and held that the defendant's machine (shown in the Langer patent, R. 297) did not infringe claim 1 of the Dickinson patent. The Court of Appeals based this conclusion on erroneous premises, (a) that claim 1 of the Dickinson patent is narrowly limited by the existence in the prior art of the Firchau patent, (b) that the Dickinson patent is lacking in utility because the machine is not commercially operative, (c) that the Dickinson patent is not a pioneer patent and therefore entitled only to a narrow construction, and (d) that the defendant's machine does not have the specified relative in and out motion of the Dickinson patent, but does have a true figure-8 movement.

It has already been fully pointed out elsewhere in this brief, (a) that the Firchau patent, as has been explained, had no bearing on the situation because it does not show a candy-pulling machine having three pins or having the relative in and out motion described in the Dickinson machine which features are essential to a candy-pulling machine. (b) That the Dickinson patent is a pioneer patent in the art, and furthermore is a broad patent on the type of machine which employs three or more pins moving with the specified relative in and out movement. And (c) that the machine of the Dickinson patent is

clearly operative, though not as good a machine as other subsequent improvements.

It remains therefore to be determined whether the Court of Appeals for the Ninth Circuit was correct in holding that the defendant's Langer machine is of a type so different from Dickinson's that it is outside the scope of claim 1 and must be differentiated from the widely varying types of machines which have already been held to be within the scope of claim 1 of the patent in suit.

In coming to its conclusion the Court of Appeals found that the defendant's machine had the plurality of oppositely disposed hooks or supports called for by the claim. It also found that both machines have means for producing a relative in and out motion of the hooks, but it held that the Langer machine did not have the particular relative in and out motion which is specified in the Dickinson patent and therefore concluded that the Langer machine did not infringe, being influenced in part by the fact that the pins of the Langer machine described a true figure 8, whereas, the court found it impossible to discover a figure-8 movement in the Dickinson machine, and being influenced further by the fact that in the Langer machine the pulling force was exerted continuously on the mass of candy suspended in the air.

Thus analyzed this part of the case is reduced to the question whether the movement of the candy-pulling hook of the defendant's machine is the same or different from the movement of the hook of the Dickinson machine, and if they are different whether they differ to such an extent as to place the Langer machine outside the scope of claim 1, when the claim is given the breadth of construction to which it is entitled by reason of Dickinson's position in the art of candy pulling.

The Identity of the Movements of the Dickinson and Langer Machines.

In the diagrams on the opposite page, corresponding successive positions of the two machines and of the hanks of candy on the pins have been shown side by side to permit of easy comparison.

In Fig. 1 of both sets of figures there is a straight bar of candy between two of the pins. In Fig. 2 this bar of candy has been converted into a V-shape. In Fig. 3 the candy has been lapped along one leg of the V so that the leg is comprised by a double strand. In Fig. 4 this strand has been changed from a double to a triple strand. This completes one cycle of movement of the machine. In Fig. 5 the new cycle is beginning, and the portion of candy between *a* and *b* is a triple strand while the portion between *b* and *c* is a quadruple strand. Succeeding cycles are the same, except that the number of fibres in the strands increase by geometrical progression.

It will also be seen that the pin *c* is the "in-between" pin twice as often as are the other two, and that the cycles of the two machines are identical in this respect as well as in every other respect.

This identity of movement between the two machines is not accidental, but results from the essential nature of a candy-pulling machine. Omit this sequence of movement from the defendant's machine and it will not pull candy. Let the moving member of the defendant's machine travel in a large circle outside of both the stationary pins or in a circle which includes only one of them, and the machine will not pull candy. This movement is the vital principle of the candy-pulling machine which Dickinson contributed to the art. Not found in the Firchau prior art machine, but found in the defendant's ma-

DICKINSON'S MACHINE
PLAINTIFF-PETITIONER

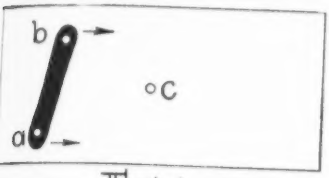

Fig.1.

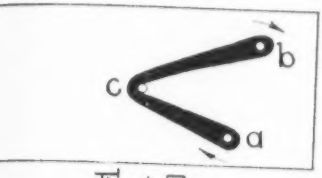

Fig.2.

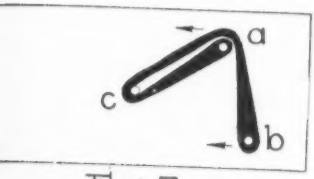

Fig.3.

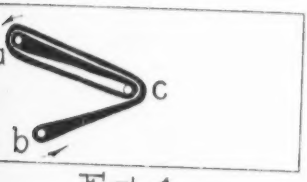

Fig.4.

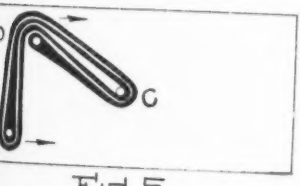

Fig.5.

LANGER
DEFENDANT-RESPONDENT

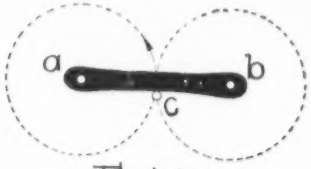

Fig.1.

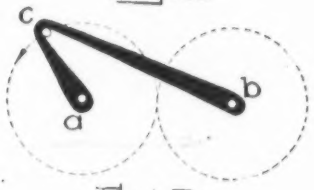

Fig.2.

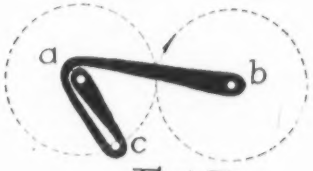

Fig.3.

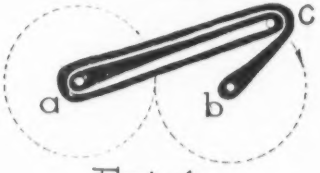

Fig.4.

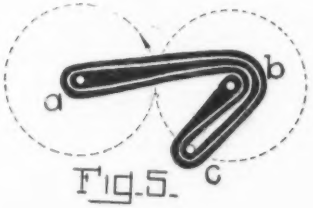

Fig.5.

Fig.1 - PIN c IS ABOUT TO PASS BETWEEN PINS a AND b
Fig.2 - PIN a IS ABOUT TO PASS BETWEEN PINS b AND c
Fig.3 - PIN c IS ABOUT TO PASS BETWEEN PINS a AND b
Fig.4 - PIN b IS ABOUT TO PASS BETWEEN PINS a AND c
Fig.5 - BEGINS A NEW CYCLE.

chine, it is that indescribable something which defendant has adopted from Dickinson and which galvanizes his otherwise useless machine into life as a practical candy-pulling machine.

The Court of Appeals was completely misled by differences in outward or structural appearance and also was influenced strongly by the fact that in the Langer machine the "single pulling member moving in a continuous circular path continuously exerts a pulling force on a mass of candy suspended in the air".

These differences exist but they serve only to emphasize the fundamental similarity of the two machines, rather than to differentiate them. It is true that in the Langer machine the candy is suspended on the pins instead of being supported on the bottom of a trough, and there is no doubt that in this respect Langer's machine is an improvement, but the fact that it is an improvement presupposes the fact of the identity of the foundation on which the improvement is built. Likewise the movement of the single pulling member of the Langer machine in a continuous circular path undoubtedly constitutes an improvement over Dickinson's mechanism, because a continuous circular movement is preferable mechanically to a reciprocating movement which involves a sudden stopping and starting of the parts, but even if the Langer machine is an improvement on the Dickinson machine, it simply results in a finer structure built on the foundation which Dickinson laid. There can be no doubt whatever that Langer was indebted to Dickinson for the foundation on which he built and this fact is conclusive that the defendant is an infringer.

In view of the perfect identity between defendant's machine and the machine of the Dickinson patent can

infringement be avoided by any such unessential changes in form as those which influenced the Court of Appeals for the Ninth Circuit to reach its decision? Can the defendant be allowed to purloin the vital principle of the patent in suit and escape by using a circular instead of a straight line movement? Can he escape the consequences of his infringement by changing the cloak in which the invention is garbed?

Langer's Machine is a "Mere Reversal of Parts", and even Includes a Detail of Construction Taken from the Dickinson Patent.

The question of infringement will also be considered from another point of view. In the Dickinson machine there is a stationary pin and two moving pins which travel in the prescribed path so that the three pins have the peculiar sequence of movement already described.

In defendant's machine two pins are stationary and the third travels about them producing the same sequence of movements. Therefore the defendant has merely made the movable element stationary and the stationary element movable—a mere reversal of the corresponding parts of the Dickinson machine. Such a reversal does not avoid infringement.

A mere reversal of parts will not avoid infringement.

> See *Anchor Cap & Closure Corp.* v. *Pritchard*, 232 Fed. 156.
> *Walker* v. *Giles*, 218 Fed. 637.

Defendant has also even adopted a detail of construction from Dickinson's machine. The two switching levers 15 of the Langer machine correspond with the stops D D' of the Dickinson machine and enable the moving

member in the Langer machine to pass around the two stationary members exactly as the stops D D' of the Dickinson machine reverse the position of the two moving members so that they can pass on opposite sides of the stationary member. While claim 1 is not limited to this construction, the fact is important as it shows that Langer not only seized the main principle of Dickinson's machine but was obliged to adopt in addition thereto an important detail invented by Dickinson.

LAW AS TO THE CONSTRUCTION OF THE DICKINSON PATENT.

As has been shown in the preceding pages of this brief, the Dickinson patent occupies a commanding position in the art to which it pertains, and therefore it is entitled to be broadly construed and to a wide range of equivalents. In *Morley Machine Co.* v. *Lancaster*, 129 U.S. 263-273, this Court said:—

> "Morley, having been the first person who succeeded in producing an automatic machine for sewing buttons of the kind in question upon fabrics, is entitled to a liberal construction of the claims of his patent. He was not a mere improver upon a prior machine which was capable of accomplishing the same general result; in which case, his claims would properly receive a narrower interpretation. This principle is well settled in the patent law, both in this country and in England. Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the

separate mechanisms which go to make up the machine."

These matters are stated accurately in the following excerpts from Walker on Patents, Fifth Edition:—

"Sec. 359. Primary inventions are entitled to a somewhat looser application of this definition of an equivalent than those inventions which are secondary. . . . A primary invention is one which performs a function never performed by any earlier invention. . . .

"Where an invention is one of a primary character and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result, are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine. . . .

"It is well settled that a greater degree of liberality and a wider range of equivalents are permitted where the patent is of a pioneer character than where the invention is simply an improvement, may be the last and successful step, in the art theretofore partially developed by other inventors in the same field."

And the following from the *Paper Bag Patent Cases*, 210 U.S. 415:—

"It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents, but that it was decided that the range of equivalents depends upon and varies with the degree of invention."

Walker on Patents:—

"Sec. 362. There are two tests of equivalency. (1) Identity of function. (2) Substantial identity of way of performing that function. Primary as well as secondary patents are infringed by no substitutions that do not respond fully to the first of these tests. The second of these tests is somewhat elastic, because it contains the word 'substantial'. That word is allowed to condone more and more important differences in the case of a primary patent, than in the case of a secondary one. . . .

"Sec. 363. A change of form does not avoid an infringement of a patent, unless the form shown in the patent is necessary to the functions which the patent ascribes to the invention; or unless that form is the distinguishing characteristic of the invention; or is essential to its patentability; or unless the patentee specifies a particular form as the means by which the effect of the invention is produced; or otherwise confines himself to a particular form of what he describes."

The rule has also been stated by the Circuit Court of Appeals for the Second Circuit in *Electric Co.* v. *Pittsburgh*, 125 Fed. 926.

In that case the Bradley patent occupied substantially the same position in the art of separating aluminum from its ores by electricity as the Dickinson patent occupies in the candy-pulling machine art, since both had been preceded by abortive attempts to accomplish the same result. Furthermore, it was argued that the Bradley process was not operative, and therefore not entitled to a broad construction. In discussing the defendant's

contention the Court of Appeals used the following language (p. 937):—

> "Various other limitations upon the claims are urged by which the defendant seeks to avoid infringement. They are of the same general nature and proceed upon the same initial fallacy, namely, that in a generic process patent every phenomenon observed during operation and every minute detail described must be read into the claims and that the least departure from the claims as so construed avoids infringement. Neither position is tenable. In a patent like Bradley's the claims should be as broad as the invention and, even if unnecessary and unreasonable limitations are incorporated in the claims, the court should interpret them liberally and not permit a defendant to escape who reaches the same results by analogous means, though he may employ additional elements and improve mechanical appliances."

The case of *Sessions* v. *Romadka*, 145 U.S. 29, decided by this Court in 1892, is in its facts very closely similar to the case at bar. In that case the Taylor patent was held to be a pioneer patent although it was preceded by seven prior patents, each of which the Court discussed in detail. The Court said:—

> "There are none of these patents which contain the peculiar combination of the Taylor device, none which, had Taylor known of them, would have suggested his own invention. While his device is somewhat crude as compared with the improved styles of trunk fasteners now in use, it contains the underlying principle of all of them.
>
> . . . The essential features of each (defendant's de-

vice and that of the patent in suit) are the same. . . . Both are identical in principle, operation and design, though the trunk fasteners now in ordinary use resemble the Taylor more than the Romadka patent. In view of the fact that Taylor was a pioneer in the art of making a practical metallic trunk fastener, and invented a principle which has gone into almost universal use in this country, we think he is entitled to a liberal construction of his claim, and that the Romadka device, containing as it does all the elements of his combination, should be held an infringement, though there are superficial dissimilarities in their construction."

These cases make it clear that the Dickinson patent being a very broad patent is entitled to the benefit of a broad range of equivalents. The claims should be as broad as the invention and should be interpreted liberally and the defendant should not be permitted to escape the charge of infringement since he has reached the same results by analogous means. Dickinson undoubtedly was the first to invent the combination of three or more candy pulling pins having a relative in and out motion. The prior art discloses no such construction. The defendant's machine employs this construction, but in spite of these facts the Court of Appeals construed Dickinson's patent more narrowly than Dickinson's invention and held claim 1 was not infringed by defendant's machine which employs the very means invented by Dickinson. We respectfully submit that the Court of Appeals erred in these conclusions.

THE CONFLICT OF OPINION AS TO THE ALLEGED PRESUMPTION OF NON-INFRINGEMENT OF PRIOR PATENTS ARISING FROM THE GRANT OF A LATER PATENT.

The next nine pages of this brief deal with a subject which is perhaps not absolutely essential to the decision of the issues of the case. Neverthless, since the Circuit Court of Appeals for the Ninth Circuit relied on the alleged presumption of non-infringement in reaching its conclusion as to infringement of the Dickinson patent and since the existence of this alleged presumption has been the subject of extended discussion and controversy between the several Courts of Appeal and the textwriters, we have discussed the question fully in the succeeding pages believing that this court ought to take this opportunity to clear up the matter for all time.

For more than twenty-five years there has been a conflict of opinion as to whether the grant of a later patent creates a presumption that the machine or process shown in this patent does not infringe the claims of a prior-granted patent.

On one side of this controversy is found the Ninth Circuit as well as the Second and Eighth Circuits, and some Districts of the Third Circuit, which hold that such a presumption exists, while on the other side of the controversy is the Sixth Circuit and the leading textwriters such as the authors of Walker on Patents and Hopkins on Patents. The Ninth Circuit has wavered* on this subject, but the decision in the case at bar re-established the fallacious rule.

* *Simplex Window Co.* v. *Hauser Reversible Window Co.*, 248 Fed. 919.

The conflict of opinion between the several circuits has arisen because the courts have confused the presumption of novelty resulting from the grant by the Patent Office, with an alleged presumption of non-infringement, and have failed to distinguish between questions of novelty and infringement. There is no doubt that the grant of a patent raises a presumption of patentable novelty over what has gone before, but the existence of a patentable difference does not carry with it any conclusion either one way or the other as to whether the device of the later patent includes previous inventions and therefore infringes the patents covering them.

The distinction can be best made clear by an illustration: Let it be supposed that Jones invented a new kind of sewing machine and obtained a patent therefor, and that Smith improves Jones' type of sewing machine by inventing a novel device capable of use only on Jones' type of sewing machine, and that a patent is granted by the Patent Office to Smith for his improvement. The grant of the Smith patent raises a presumption that Smith's improvement is novel and not disclosed in Jones' prior patent, because it has been examined by the Patent Office and found to be novel. On the other hand, it is equally apparent that there can be no presumption that a machine which includes Smith's invention does not infringe the claims of Jones' patent because *ex hypothesi* Smith's invention can be used only on the Jones machine.

The Erroneous Doctrine.

The erroneous doctrine of the Ninth Circuit appears to have originated in the case of *Ransome* v. *Hyatt*, 69 Fed. 148, in which the court took the position that *Corning* v. *Burden*, 15 How. 265, was expressly re-affirmed by

this Court in *Miller* v. *Manufacturing Co.*, 158 U. S. 208 and *Boyd* v. *Janesville Hay Tool Co.*, 158 U. S. 260 and quoted with approval the statement from *Corning* v. *Burden*—

> "It is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor . . . that his machine is new, and not an infringement of the patent previously granted to the plaintiff."

In its decision in the case at bar, the Ninth Circuit said—

> "It is a legal presumption that a later patent does not infringe an earlier patent. *Putnam* v. *Keystone Bottle Co.*, 38 Fed. 234; *Ney* v. *Ney Mfg. Co.*, 69 Fed. 405; *St. Louis Car Coupler Co.* v. *National Malleable Castings Co.*, 87 Fed. 885; *Griffith* v. *Shaw*, 89 Fed. 313; *Norton* v. *Jensen*, 90 Fed. 415; *Century Elec. Co.* v. *Westinghouse Co.*, 191 Fed. 350; *Benthall Mach. Co.* v. *National Corporation*, 222 Fed. 918, 932.

Of the seven cases cited by the Court of Appeals, only three[1] support its position at all, while the other four[2] relate solely to the presumption of novelty.

[1] *Griffith* v. *Shaw*, 89 Fed. 313.
Century Elec. Co. v. *Westinghouse Co.*, 191 Fed. 350.
Benthal Machine Co. v. *National Corporation*, 222 Fed. 918, 932.

[2] *Putnam* v. *Keystone Bottle Co.*, 38 Fed. 234.
Ney v. *Ney Mnfg. Co.*, 69 Fed. 405.
St. Louis Car Coupler Co. v. *National Malleable Castings Co.*, 87 Fed. 885.
Norton v. *Jensen*, 90 Fed. 415.

Other Cases Supporting the Ninth Circuit.

SECOND CIRCUIT. The Second Circuit has *followed* the ruling in the Ninth Circuit in—

Autopiano Co. v. *Amphion Player Piano Co.*, 186 Fed. 159, 165.

Superior Sky-Light Co. v. *Kuhnla, Inc.*, 265 Fed. 282.

United States Fastener Co. v. Meyers, 145 Fed. 536.

Simplex Electric Heating Co. v. *Leonard et al.*, 180 Fed. 763.

Frank F. Smith Metal Window Hardware Co. v. *Yates*, 216 Fed. 361.

EIGHTH CIRCUIT. The Eighth Circuit followed the Ninth Circuit in—

Union Match Co. v. *Diamond Match Co.*, 162 Fed. 148, 156.

Century Elec. Co. v. *Westinghouse., supra.*

THIRD CIRCUIT. Decisions by District Courts in the Third Circuit follow the Ninth Circuit in—

Crowe v. *Oscar Barnett Foundry Co.*, 206 Fed. 164.

General Electric Co. v. *Allis-Chalmers Co.*, 197 Fed. 558, 561.

Byerly et al v. *Standard Asphalt & Rubber Co.*, 189 Fed. 759.

THE CORRECT DOCTRINE

The correct view of the question of law under consideration is that *no presumption of non-infringement arises from the grant of a patent.*

This view is perhaps best stated by Judge Finkelnberg in *Electric Candy Machine Co.* v. *Morris*, 156 Fed. 972, 975, (Eastern District of Missouri), although this ap-

pears to have been overruled by the Circuit Court of Appeals for the Eighth Circuit in *Union Match Co.* v. *Diamond Match Co.*, 162 Fed., 148, 156, and *Century Electric Co.* v. *Westinghouse*, 191 Fed., 350, both cited *supra*.

Judge Finkelnburg said—

> "But it is claimed that the Kochs' patent raises a prima facie presumption that there is a patentable difference between defendant's machine and complainant's machine. But this presumption does not exclude the fact that the later patent may embody things which are the exclusive property of the complainant under a prior patent. In other words, it may be that Koch's patent contains improvements which this complainant cannot use, but it does not follow that therefore Koch's patent also absorbs improvements theretofore invented by and patented to complainant's assignors. If, therefore, as the court has found, defendant's machine infringed on certain essential features of complainant's machine, the mere fact that it is constructed in accordance with a subsequent patent issued to another party is no defense."

The learned author of Hopkins on Patents disagrees with the Ninth Circuit and says (Sec. 19)—

> "**Does the grant creat a presumption that the thing patented does not infringe prior patents?**
>
> "This question has given rise to a controversy that is one of the most notable incidents in the growth of our patent law. . . ."

After discussing some of the cases on the subject, Mr. Hopkins goes on to say (page 33)—

"It is upon this slender foundation that the Ninth Circuit Court of Appeals has held that *Blanchard* v. *Putnam* has been overruled. It is impossible for us to follow the Court of Appeals in this conclusion.

The Miller and Boyd cases both relate to the presumption of patentable difference rather than to that of non-infringement.

Inasmuch as a patent may improve upon and yet infringe a prior patent, it is the writer's conclusion that while it is always competent to show that the defendant is operating under a junior patent for the purpose of showing a patentable difference between his device and that of the patent in suit; the fact that he is operating under such a patent does not create even a prima facie defense to the charge of infringement. And this conclusion is not in conflict with the rule that the issuance of the defendant's patent creates a presumption of patentable difference between the patent and all those which precede it; indeed, it is in perfect harmony with that rule, for as long as the Patent Office is bound to issue patents for patentable improvements even though they infringe, it is *reductio ad absurdum* to say that the grant raises a presumption of non-infringement."

Walker on Patents (Fifth Edition) Sec. 362 A, contains a dissertation on this subject too long to be copied here, and the learned authors come to a conclusion substantially the same as that stated in Hopkins on Patents. Walker on Patents also disagrees altogether with the Ninth Circuit and says that the case of *Herman* v. *Youngstown Car Mfg. Co.*, 191 Fed. 579, decided by the Sixth Circuit, states the law on the matter correctly. In that case Judge Denison said:—

"Defendant's device is manufactured under patent No. 765,406, issued July 19, 1904, to J. H. Wagenhorst, and the court below gave to this fact some force in reaching his conclusion that the device did not infringe. We think that the granting of the later patent and defendant's conformity thereto are not of importance in this case on the infringement issue. There are expressions in some reported cases implying that by the later patent the government has granted a right to make and use the article so patented, and that such grant is inconsistent with any construction of the earlier patent which would forbid the manufacture of the later structure. Such implication rests on a fundamental error. A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder.

Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the conclusion. In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay

any attention thereto. It is concerned only with the early disclosure by the specification and drawings. Patentable difference does not of itself tend to negative infringement. . . .

As the necessary result of the fundamental principles, it seems that the existence of the later patent can have no tendency to disprove infringement, unless, for other reasons, we have first reached the conclusion that the earlier patent is, as to the later structure, specific, and not generic."

Judge Denison then discusses some previous cases with the clearness characteristic of his opinions, but this portion of his opinion need not be quoted.

THE SIXTH CIRCUIT has re-iterated the substance of this opinion in the following cases:—

J. F. Rowley Co. v. *Columbus Pharmacal Co.*, 220 Fed. 127.

General Electric Co. v. *Electric Controller & Mfg. Co.*, 243 Fed. 188, 193.

Curry v. *Union Electric Welding Co.*, 230 Fed. 422.

General Electric Co. v. *Cooper-Hewitt Electric Co.*, 249 Fed. 61, 66.

Murray v. *Detroit Wire Spring Co.*, 206 Fed. 465.

T. B. Woods Sons Co. v. *Valley Iron Works*, 191 Fed. 196.

The Decision of This Court in Kokomo Fence Co. v. Kitselman, 189 U.S. 8.

The above case decided by this court in 1903 has sometimes been cited as supporting the position of the Ninth Circuit. In this case the Court said (page 23)—

"Considering complainant's and Whitney as alike

> having improved on the prior art, the question is whether the specific improvement of the one actionably invaded the domain of the other. The presumption from the grant of the letters patent is that there was a substantial difference between the inventions."

In that case, the complainant and Whitney were practically on a parity with each other, both being improvers on the prior art, and the court seems to have concluded that Whitney's patent was not an improvement on the machine of the plaintiff's patent. If this is the case, it is clear that this court did not intend to lay down the broad doctrine that the grant of a patent always raises the presumption of non-infringement of a prior patent, and therefore the case at best only applies to situations where the facts are like those in the Kokomo Fence case. This view of the case is that set forth in Walker on Patents, Fifth Edition, Sec. 362A, pages 448, 449—

> "In the Kokomo case it will be noted that the court had before it two patents, both of which were improvements on the prior art, and it was said that 'the presumption from the grant of the letters patent is that there was a substantial difference between the inventions.' As there may be and in fact are in the cases of a multitude of patents, improvements upon improvements as well as improvements of different species, it must be admitted that the Kokomo case lends considerable judicial support to the doctrine, unless the court meant by the phrase 'substantial difference' a difference in species. If, however, the court meant, as is said in substance in *Autopiano Co.* v. *Amphion Piano Player Co.* that the presumption arises only when

one patent is not an improvement upon the other, the doctrine as thus modified would seem to be a reasonable application of the rule of presumption attaching to the issuance of a patent."

Conclusion as to the Alleged Presumption of Non-Infringement.

We, therefore, respectfully submit that in cases like the case at bar where the art has developed from the parent stock of a pioneer or basic patent, or even from a patent which has also been improved upon subsequently, there is no such presumption of non-infringement from the grant of a subsequent improvement patent as has been laid down by the Ninth Circuit.

It is also respectfully submitted that the Kokomo Fence case is not susceptible of any such broad application and that the true doctrine is that fully explained in the decisions in the Sixth Circuit, namely that the grant of a patent has no bearing whatever on the question whether or not the machine of that patent includes within it the inventions which have been previously made and patented by earlier inventors.

THE PRIOR ADJUDICATIONS OF THE DICKINSON PATENT.

In addition to the litigation in the Patent Office and in the Court of Appeals of the District of Columbia over the question of priority of invention, which litigation has been fully described in the earlier pages of this brief, the Dickinson patent has been involved and fully sustained in three other suits.

Hildreth v. Lauer & Suter Company.
Fourth Circuit.

In this case, the first claim of the Dickinson patent was held valid and infringed by Judge Rose in the District Court of Maryland. (Rec. 167.)[1] On appeal to the Circuit Court of Appeals for the Fourth Circuit, the decision was sustained in the opinion of Circuit Judge Woods. (Rec. 185.)[2] Only a single paragraph of Judge Woods' opinion deals with the Dickinson patent, the remainder of the opinion having to do with the Jenner patent which was also in suit. He said—

> "The reasoning of the District Judge, by which he reaches the conclusion that the defendant's candy-pulling machine operating under the Henry patent is an infringement of the prior right of the complainant Hildreth as assignee under the first claim of the Dickinson patent, leaves nothing to be added. While strong argument against it has been submitted, we think it remains unbroken."

Therefore, the Court of Appeals for the Fourth Circuit, practically adopted in toto Judge Rose's opinion.

The defendant's machine in that case was a Racine machine, built like the Henry patent No. 731,681. (Rec. 227.) In that machine there was one stationary pin and two pins which travelled in intersection circles, passing on opposite sides of the stationary pin. The defendant's (Henry) machine in that case resembled the defendant's machine in the present case because the path of movement of the moving members was circular and of a true

[1] 208 Fed. Rep. 1005.
[2] 219 Fed. Rep. 753.

figure 8 character. Judge Rose held that claim 1 was infringed by this machine.

The defendant in that case also argued that the Dickinson patent was anticipated by the Firchau patent, that the machine of the Dickinson patent was inoperative, that the claim was limited by implication to machines having troughs and did not cover machines in which candy is hung on the pins, and that the claim of the Dickinson patent was invalid because functional. Judge Rose disposed of all these contentions and held claim 1 of the Dickinson patent valid and infringed. He said of the Dickinson invention—

> "The Patent Office was right in finding this feature in every one of the six applications. It was the basic principle common to them all. It made every one of them a more or less operative machine for pulling candy. No earlier attempt* to invent a candy-puller had made use of it. Without it, the prior art was destitute of any machine which had any value either as a candy-puller or as a suggestion of how a useful one might be constructed. So soon as it was discovered, progress was rapid." (Rec. 170.)

In characterizing Dickinson's invention, Judge Rose uses the expressions—

> "The first discovery of the basic principle."
> "Dickinson's fundamental discovery."
> "An invention which was epoch-making."

and other similar expressions.

As a whole, Judge Rose's opinion is painstaking, accu-

* This has reference to the Firchau patent.

rate, and sound and based on a correct understanding of the questions of fact and of patent law involved. The Court of Appeals for the Ninth Circuit is hopelessly at variance with Judge Rose, and being based on erroneous conclusions of fact and principles of law ought to be reversed.

Hildreth v. E. J. Smith Co.

This was a suit brought on claim 1 of the Dickinson patent in the Southern District of Florida. In that case, the defendant was using an Igou machine built under patent No. 752,979. (Rec. 272.) The case turned on the question of infringement, but is valuable because the Igou machine is of a type entirely different from the Henry machine, which was the subject of the suit in the Fourth Circuit. In the Igou machine, there are three candy-pulling pins, all of which move. Two of them oscillate on opposite ends of a beam, while the third is swung back and forth between and around the other two pins, being carried on the lower end of a pendulum. Judge Call said—

> "The testimony shows that the complainant is the owner of the Dickinson patent, and that said patent was duly issued by the Patent Office after a considerable contest before the Patent Office and before the Court of Appeals of the District of Columbia, and that claim 1 was sustained in all these proceedings; so that it may be assumed without fear of successful contradiction that said Dickinson patent is valid in this particular claim." (Rec. 188-9.)

He also said—

> "While the machines are entirely different in appearance, the result of their operation, to wit, the

pulling of the candy in a figure 8 movement is exactly the same, and accomplished by hooks or pins, and is, I have no doubt, an improvement on the original machine. But this does not authorize the use of the patented idea covered by claim 1 of the Dickinson patent."

This case was not appealed.

Hildreth v. Koerber.
Eastern District of Michigan.

In addition to these adjudications which are fully set forth in the record of the case, claim 1 of the Dickinson patent has been held valid and infringed by District Judge Tuttle of the Eastern District of Michigan in a case decided after the trial of the case at bar. For this reason, no reference of this case is found in the record. In that case, the defendant machine was made in accordance with the Koerber patent No. 1,096,278, dated May 12, 1914. In that machine there were also three pins, all of them movable. Two of the pins were on sliding members and advanced toward and receded from each other in a straight line, while the third pin was on the end of a crank arm and travelled in a circular path, making two revolutions for each complete reciprocation of the other two pins, so that this pin first made a circle around both the other pins and then made a circle around one of the other two pins. Although this machine was altogether different in appearance from the Dickinson machine and although it contained but little suggestion of the figure 8 since the pin which travelled in a circle never changed its orbit, Judge Tuttle held that it infringed the Dickinson patent. Since this case was referred to a master to find the facts, and as Judge Tuttle affirmed the report without any opinion, we cannot quote

any statement from Judge Tuttle. The Master's report* and Judge Tuttle's decree are, however, of record in that court. The case was then appealed to the Circuit Court of Appeals for the Sixth Circuit, but before argument, the defendant obtained leave of court to withdraw the appeal. The case is valuable here because in it claim 1 of the Dickinson patent was once more sustained after a bitter contest in which similar arguments were made in defense as were presented to the Circuit of Appeals for the Ninth Circuit in the present case.

*The following are the more important findings of the master in *Hildreth* v. *Koerber*:—

> 5. Herbert M. Dickinson, the inventor of the Dickinson machine constructed under the so-called Dickinson Patent and now owned by the plaintiff herein, was the first inventor of and patentee of a candy-pulling machine, and his patent for such a machine is the pioneer patent in this art. . . .
>
> 7. I find that the "specified relative in-and-out motion" referred to in said claim is a motion in which each member of the candy-pulling machine at one time passes between the other two and later becomes one of the two between which the third member passes. . . .
>
> 9. In the machine of the Dickinson patent the pulling operation is performed by pins or hooks which are acted upon by the operating mechanism in such a manner as to give peculiar relative movement by which the candy is repeatedly stretched or pulled and lapped and pulled again with the same effect as that of the hand pulling hereinbefore mentioned.
>
> 18. While the form of defendant's machine differs from the form of the device shown in the drawings of said Dickinson Patent, yet, I am satisfied, and I find, that the mode of operation of said machine which makes it an effective candy-pulling machine is the means of producing a movement of its members, i. e., its reciprocating candy-hooks and candy-puller, the latter being in the form of the revolving crank arm mentioned, during which movement each of said members is at one time between the other two, and at another time is one of two between which the third member moves.
>
> 19. I find that the defendant's machine employs substantially the same mode of operation as does plaintiff's machine con-

PLAINTIFF'S PATENT IS NOT AN ATTEMPT TO PATENT THE FUNCTION OF THE MACHINE.

The Court of Appeals says in effect that if the movement of the Langer machine be assumed to be the same as the movement of the Dickinson machine, and if it be assumed that claim 1 of the Dickinson patent covers the Langer machine, then Dickinson has attempted to patent the function of his machine. The court cites *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 569, in support of this point. In that case, the court said—

> "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in

structed under the Dickinson patent and thereby produced substantially the same result. . . .

24. The relative movement of the pins in the Dickinson machine is the same as would result if the two moving pins were stationary, one between the central pin and one end of the trough, and the other between said pin and the other end of the trough, and the last mentioned pin were moved around the other pins in a path corresponding to a figure eight. In other words, there is no moving candy-pulling part which moves in a figure eight path, but the pulling effect is the same as would result if one of the pins did move in such a figure eight path around the other two, which were then stationary. . . .

27. To summarize, I find that the Koerber machine employs substantially the same means to produce the same result in substantially the same manner as does the Dickinson machine, and that therefore such Koerber machine constitutes an infringement of the Dickinson patent in suit.

other language, that he is entitled to patent his function."

The question as to whether or not claim 1 of the Dickinson patent was functional was carefully considered by Judge Rose of the District Court of Maryland and affirmed by the Court of Appeals for the Fourth Circuit, in *Hildreth* v. *Lauer & Suter* (Rec. 179). Judge Rose said:—

"Defendant says, however, that if so much be held against it, still this claim must be stricken down because it is so broad that it is for the function or mode of operation of a machine. In most cases in which a claim has been held to be functional, the inventor has claimed more than he invented, or at all events he claimed an exclusive right to do in any and every way something that other people had wanted to do before he did it. He asserted this right merely because he was the first person who had succeeded in doing it at all. The possibility and the desirability of using the power of the electric current to make intelligible signs at great distances had been recognized by many men before Morse found a method of doing it. Being the first inventor of that method he was entitled to the monopoly of it for the statutory period. Moreover, as a pioneer he was entitled to have his claims so construed as to cover the broadest possible range of equivalents. Yet in his famous eighth claim he asked for more. If it were valid he would have the right to say that other men who had been seeking the same goal could not now approach it even by a path over which he had thrown no light. . . .

"Before Dickinson perfected his invention men had wanted a candy-pulling machine. He found

out how one might be made. That would have given him no right to a claim for a machine to pull candy. Such a claim would have been in relation to what he actually invented, as the eighth claim of Morse or as the fourth claim of Hildreth. But before Dickinson no one had wanted to make a machine with the in and out motion. That it was desirable to make such a machine for such a purpose was his idea. Whatever may be said of his claim, it is at least no broader than was his invention.

"But is there any real reason for saying that a claim limited to a combination of a plurality of oppositely disposed candy hooks or supports, a candy-puller and means for producing a specified relative in and out motion of these parts for the purpose of making candy travel over a figure 8 pathway, is in any sense functional? . . .

"In no ordinary sense of the words does this claim appear to be functional. It is true that it covers many different machines which in appearance and details of construction are very unlike that of Dickinson and are, as among themselves, dissimilar. Yet it covers them because the operative principle in all of them is the one he was the first to contribute to the industrial knowledge of mankind. He brought that discovery to the Patent Office, that appointed treasury and storehouse for additions to the world's stock of materially useful information. He left it there and received in return the price the Government offers to all inventors—the exclusive monopoly for seventeen years of the right to make, use and vend his invention. There is every reason why he should not be allowed to receive or to hold a grant which goes beyond the price he has paid,

there is none why he should be deprived of any part of the invention he has made, when, as in this case, he has asked for and has been given an aptly worded grant which accurately defines the precise limits of that which was the essence of his invention."

The Dickinson patent is certainly no more subject to criticism than was the patent in suit in the *Paper Bag Cases*, 210 U. S. 405, 417. In that case the Circuit Court said:—

"The pith of the invention . . . is the combination of the rotary cylinder with means of operating the forming plate in connection therewith, limited, however, to means which cause the plate to oscillate about its rear edge."

In commenting on this statement, this court said:—

"The court [lower] expressed the opinion that the invention extended to every means by which that result could be attained." . . .

"The distinction between a practically operative mechanism and its function is said to be difficult to define. Robinson on Patents, § 144, *et seq.* It becomes more difficult when a definition is attempted of a function of an element of a combination which are the means by which other elements are connected and by which they co-act and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art. It is the thing that never had been done before, and both the lower courts found that the machines of the Continental Com-

pany were infringements of it. It is not possible to say that the findings of those courts on that fact or on the fact of invention were clearly wrong, notwithstanding the great ability of the argument submitted against them."

Certainly the claim in the present case is not more for a mode of operation of a machine than was the claim in the *Paper Bag Cases*.

See also *Leeds & Catlin* v. *Victor Talking Machine Co.*, 213 U.S. 301, in which the claim consisted of the combination of the following elements:—

1. A travelling tablet having a sound record formed thereon.

2. A reproducing stylus shaped for engagement with the record and *free to be vibrated and propelled by it*.

This court said that this was a true mechanical combination and sustained the district court.

Certainly a claim which specifies a "stylus free to be vibrated and propelled by it" is more objectionable as covering a mode of operation than is the claim of the patent in suit in the case at bar.

The Court of Appeals for the Ninth Circuit also said that Dickinson acquired no monopoly of all in-and-out motions in candy-pulling machines. Counsel for petitioner does not contend that Dickinson acquired a monopoly to anything more than the mechanism and its mechanical equivalents which will produce the one relative in-and-out motion which Dickinson invented. That is all that is necessary.

Defendant's machine has clearly equivalent mechanism working in the same way and producing the same results as Dickinson's machine, and is an infringement

because of the mechanism employed and not because the Dickinson patent attempts to cover the functions of the machine.

DISTRICT JUDGE WOLVERTON'S OPINION IN THE CASE AT BAR.

Especial attention is called to the opinion of District Judge Wolverton in the case at bar. This opinion is of supreme importance because Judge Wolverton heard the witnesses and saw the demonstration of the machines. He understood the subject-matter of the case with a completeness which the Court of Appeals failed altogether to attain.

Judge Wolverton disposed of the Firchau patent as follows:

> "The Firchau concept was not in its operation a machine for pulling candy at all, but one for working or mixing candy. The contrivance consists of a drum with two pins or fingers extending therein, which are rotated in opposite directions, and *has none of the elements of the Dickinson machine.*" (Rec. 20.)

Judge Wolverton then discussed the operativeness of the Dickinson machine at considerable length. He refers to the evidence of the plaintiff, adopted it as his conclusion and then adverts to the demonstration of the Dickinson machine in court, saying:—

> "It is within itself a demonstration that it pulls candy."

Judge Wolverton then explains with great clearness certain theoretical reasons why the Dickinson machine pulls candy successfully.

He reviews the interference proceedings, explaining that they throw light on the scope of the Dickinson patent and says that all the machines involved in the interference pull candy because they all included pins having the intersecting or in-and-out movement relatively to each other. Judge Wolverton concludes that the Dickinson patent is a pioneer patent and therefore entitled to a broad construction. As to the defendant's machine, Judge Wolverton says:—

> "The defendant's machine has the relative in-and-out movement perfectly, and without it the machine would not pull candy. It is of a type, respecting the basic principle of its operation, not different from those machines considered in the interference proceeding. It is a marked improvement on the Dickinson machine, but it cannot be operated without applying the basic principle for pulling candy by machinery which Dickinson invented; and this in itself is a demonstration that it infringes the Dickinson patent. That the defendant's machine has two stationary pins and one moving, as against two moving and one stationary in the Dickinson and Robinson patents, makes no difference. The principle of the relatively intervening or in-and-out movement of the pins is applied in each, and that is the essential thing." (Rec. 27, 28.)

Again Judge Wolverton says:—

> "Turning again to claim 1 of the Dickinson patent, its language and wording, it can be read directly upon the Langer patent, and while the mechanism is different in arrangement and in the movement of its parts, it performs the same service in substantially the same way, and the appliances

adopted by the Langer patent are but mere mechanical-equivalents of those used in the Dickinson machine." (Rec. 29.)

It is, therefore, respectfully submitted that the conclusions both of law and of fact reached by Judge Wolverton of the District Court were correct, and his decree ought to have been sustained.

SUMMARY OF ARGUMENT.

The argument contained in the foregoing pages may be summarized as follows:—

Candy-pulling consists in converting warm, plastic candy into a bundle of parallel microscopic fibres, separated by air cells, by successively stretching the hank of candy and doubling it upon itself. To do this a machine must have three pins or candy hooks and mechanism capable of giving them a relative in-and-out motion such that each pin in turn passes between the other two and in its turn is one of a pair of pins between which the third pin passes. Dickinson was the first to invent such a machine. The prior art patent to Firchau does not show such a machine because it has only two pins moving in concentric circles and does not and cannot have any relative in-and-out movement of the pulling members. In addition, the Firchau patent was a mere paper patent for no machine like it was ever built except for use as a model in court.

Dickinson's invention revolutionized candy-pulling. It did away with hand pulling and substituted machines for men.

The Dickinson patent is the pioneer in the art; it is broad and basic, and covers machines having three pins which move with the peculiar relative in-and-out motion described in his patent.

Since the machine of the patent was found to be operative by the trial judge, who, having seen a demonstration in court, believed the evidence of his own eyes, the Court of Appeals should have accepted the finding of fact of the District Court.

The Court of Appeals' test of operativeness, namely, that a machine must be commercially useful, was clearly erroneous and at variance with the rule laid down by this court, namely, that if a machine will work at all, the patent covering it is not lacking in utility.

The decisions of the Patent Office, of the Court of Appeals of the District of Columbia, of Judge Rose and the Circuit Court of Appeals for the Fourth Circuit, and of Judges Call and Tuttle are correct and ought to have been followed by the Circuit Court of Appeals for the Ninth Circuit.

As to the matter of infringement, the defendant's machine differs from the machine of the patent in suit only in being a mere reversal of the operating parts of the Dickinson machine and in embodying improvements which were grafted on the original stock of the Dickinson invention. Both the plaintiff's and defendant's machines have three candy-pulling hooks, and both would be inoperative with less than that number. Both employ the peculiar relative in-and-out motion. The movement of the parts of the defendant's machine is differentiated from that of the Dickinson machine only by the fact while retaining the relative in-and-out motion that the movement is in a circular path and not in a straight line.

When claim 1 of the Dickinson patent is given the construction to which it is entitled by reason of its position in the art, it is undoubtedly infringed by the defendant's machine.

It is respectfully submitted that the decision of the Circuit Court of Appeals for the Ninth Circuit should be reversed and the cause remanded with instructions for further proceedings.

Respectfully submitted,

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